

**REMARKS**

Claims 36-50 are pending in this application.

Claims 36, 37, 39, 41, 42, 44, 46, 47 and 49 are independent.

Amendment to Figure 3 was proposed in the response filed November 27, 2002, to address the objection raised in the Official Action dated July 29, 2002. The Examiner has not acknowledged or explicitly approved the proposed modification. However, since the objection is not reasserted in the final Official Action, it is understood that the proposed modification to Figure 3 has been accepted.

The finality of the rejection is traversed. The Examiner asserts that new grounds of rejection were necessitated due to amendments filed on November 27, 2002.

However, contrary to the Examiner's contention, the amendments to claims 36-50, only deleted unnecessary limitations and/or clarified the claim language. In fact, many of the amendments were made in accordance with the understandings reached during the interview on September 24, 2002.

Referring to the Appendix to the Amendment filed on November 27, 2002, presenting the modifications to the pending claims, the Examiner is requested to identify the explicit changes which necessitated the new grounds of rejection of each of the amended claims.

It is respectfully submitted that, for example, in the case of claim 36, the changes could not have caused the new grounds of rejection. Accordingly, it is respectfully requested that the finality of the rejection be reconsidered and withdrawn.

The claim of priority to 1991 is denied. The denial is respectfully traversed.

The present Application is a Continuation of United States Patent Application Serial Number 09/250,675, now abandoned, which is a Continuation of United States Patent Application Serial Number 08/372,620, now United States Patent Number 5,873,072, which is a Continuation of United States Patent Application Serial Number 07/736,071, now United States Patent Number 5,383,113.

The Examiner contends that two way data flow between details 22 and 24 of Figure 2 of the '072 Patent is not supported by the original disclosure of the '113 Patent. It is respectfully submitted that the Examiner is mistaken.

Figure 2 of the '113 Patent is reproduced as Figure 1 in the '072 Patent. In Figure 2 of the '113 Patent, detail 22, the consumer database, and detail 24, the FIF file, are linked by a unidirectional arrow flowing from the FIF file to the consumer database. In Figure 1 of the '072 Patent the consumer database and the FIF file are linked by a bi-directional arrow.

A unidirectional arrow generally denotes a one-way flow, and a bi-directional arrow generally denotes a two-way flow. Both the '113 Patent and the '072 Patent disclose two-way flow between the FIF file and the consumer database, even though Figure 2 of the '113 Patent only depicts a unidirectional arrow. In particular, column 2, line 65, through column 3, line 14, of the '113 Patent and column 3, lines 7-20, of the '072 Patent each teach that bank routing transit and individual account numbers are input into a computer system and that this information can be edited against the FIF file 24, which is a part of the computer system.

The information in the FIF 24 that is used for editing "may be obtained from each

banking institution and each consumer", as recited at column 3, lines 12-14, of the '113 Patent and at column 3, lines 19-20, of the '072 Patent. Thus, information received from consumers is passed to the FIF for storage, and information stored in the FIF is retrieved edit received financial institution information.

Accordingly, both the '113 Patent and the '072 Patent teach a flow of information into and out of the FIF. Therefore, the inclusion of a bi-directional arrow in Figure 1 of the '072 Patent does not constitute new matter.

The Examiner also draws attention to a link between details 32 and 36 of Figure 2 of the '072 Patent, contending that the '113 Patent and the '072 Patent each do not provide support for the link. It is respectfully submitted that the Examiner is mistaken.

Part of Figure 3 of the '113 Patent is reproduced as Figure 2 of the '072 patent, and part of Figure 3 of the '113 Patent is reproduced as Figure 3 of the '072 Patent. Detail 32, which represents information identifying a merchant, and detail 36, which represents a payment request, are reproduced in Figure 2 of the '072 Patent. Figure 2 of the '072 Patent includes the link connecting details 32 and 36, wherein Figure 3 of the '113 Patent does not include this link.

Both Figure 3 of the '113 Patent and Figure 2 of the '072 Patent show, by arrows, a payment request and information identifying a merchant flowing from a consumer to the service provider. The link of Figure 2 of the '072 Patent does not include arrow ends. As such, it does not denote any information flow. Rather, it shows an association between a payment request and information identifying a merchant.

The Examiner argues that the link of Figure 2 of the '072 Patent shows "a new

interface element of interaction" between details 32 and 36, namely adding a merchant via a payment request. As will be discussed below, this processing is disclosed in the '113 Patent as well as the '072 Patent, especially when taken in light of the fact that the specification of the as-filed '620 Application does not include any new matter, as shown in the Appendix included herewith. Inclusion of the link between details 32 and 36 does not constitute new matter, rather it merely illustrates an aspect of the invention disclosed in both the '113 Patent and the '072 Patent, namely, the functionality to add a merchant through a payment request.

The Examiner also points to Figure 3 of the '072 Patent as including matter not disclosed in the '113 Patent. Again, it is respectfully submitted that the Examiner is mistaken.

Figure 3 of the '072 Patent includes an unnumbered box labeled "rejects". This unnumbered box does not appear in Figure 3 of the '113 Patent. The text of the '113 Patent and the text of the '072 Patent disclose rejecting information received at the front end processor. In particular, attention is drawn to column 4, lines 43-46, of the '113 Patent and column 4, lines 33-36, of the '072 Patent. This text recites: "The payment [received via the front end processor] may first go through a validation process against the pay table. The validation process checks for duplicate payments and if duplicates are found they are sent to a reject file." Thus, inclusion of the unnumbered box labeled "rejects" does not constitute new matter, rather it merely illustrates an aspect of the invention disclosed in both the '113 Patent and the '072 Patent, namely, rejecting duplicate payment requests.

The Examiner also points to column 4, lines 26-21, of the '072 patent as excluding disclosure found at column 4, lines 37-41 of the '113 Patent. The Examiner contends that Applicants are attempting to broaden the scope of the invention as disclosed in the '113 Patent by the exclusion of this language. It is respectfully submitted that the Examiner is again mistaken.

The '113 Patent recites: "New merchants are compared to the MMF 42 and appropriately cross-referenced by the software of the present invention to the pay table to check if a merchant record already exists. If no merchant record exists, a merchant record will be created on the MMF 42". The '072 Patent recites: "New merchants are compared to the MMF 42 and appropriately cross-referenced to the pay table to check if a merchant record already exists. If no merchant record exists, a merchant record will be created on the MMF 42". Thus, "by the software of the present invention" does not appear in the '072 Patent.

As seen in both the '113 Patent and the '072 Patent, one implementation of the disclosed invention is achieved by the use of software. Both the '113 Patent and the '072 Patent are replete with references to the software of the present invention. The '113 Patent and the '072 Patent each disclose the operations of comparing new merchants to the MMF 42 and adding new merchants to the MMF 42 if a merchant record does not exist, can be achieved by the use of software. It would be understood by one of ordinary skill in the art that the disclosed operations could be achieved by the use of the software disclosed throughout both the '113 Patent and the '072 Patent. Exclusion of the phrase "by the software of the present invention" from the '072 Patent

does not in any way substantially alter the disclosure in the '113 Patent.

Also, the '620 Continuation Application, from which the '072 Patent matured, includes an incorporation-by-reference statement specifically incorporating the entirety of the '113 Patent. Thus, the instance of "software" recited in the '113 patent, but not the '072 Patent, is incorporated into the '072 Patent by reference. Therefore, for this reason also, the exclusion of the phrase "by the software of the present invention" from the '072 Patent does not in any way alter the scope of that disclosed in the '113 Patent.

As should be clear from the above, the '072 Patent does not include new matter not found in the '113 Patent. The scope of that disclosed in the '113 Patent is the same as the scope of the invention claimed in the '072 Patent. As such, each claim limitation in the present Application is expressly supported by the disclosure of the '113 Patent. Accordingly, priority of the present application to the filing date of the '113 Patent, i.e. July 25, 1991, should be granted and used in applying prior art to the claims of the instant application. Therefore, it is respectfully requested that the Examiner reconsider and withdraw the denial of priority.

In addition to the differences between the '113 Patent and the '072 Patent noted by the Examiner, other differences also exist. In the Appendix included herein is a discussion of each of the differences in certain sections of these patents, evidencing that none, including the ones noted by the Examiner, constitute an insertion of new matter into the disclosure of the '113 patent.

Claims 36, 38, 41, 43-46, and 48-50 stand rejected under 35 USC §112, first paragraph, as directed to subject matter not described in the application as filed. The

rejection is respectfully traversed.

The traversal arguments presented in the response filed on November 27, 2002, with respect to the rejection of claims 38 and 48 under 35 USC §112, first paragraph, are hereby reasserted in their entirety.

As can be best understood, the Examiner contends that the requirements (i) that a request to pay a bill associated with a merchant on behalf of a consumer be received, and (ii) that a determination be made if the merchant is included in a master merchant file database, and if not, that the merchant be added to the master merchant file database, are not disclosed.

However, contrary to the Examiner's assertion, as, for example, disclosed on page 6, line 15, through page 7, Figure 2 of the present application shows the steps for establishing merchants to be paid and for making payments. As described, the consumer informs the service provider or processor of the merchant information including the consumer's account, and this information is put in the merchant master file database (MMF) 42. The consumer may also indicate, for example, that the merchant is a fixed merchant and the date on which the merchant is to be paid and the amount to be paid (see for example page 7, lines 4-6). Thus, as described on pages 6 and 7, a request for payment can be made at the same time a merchant is added to the master merchant file database.

As described on pages 8 and 9, when a payment record (i.e. a request to pay a bill associated with a merchant on behalf of a consumer) is received, it is validated by checking for a duplicate payment and by verifying that the merchant is set up. As

explicitly disclosed on page 8, if a duplicate payment is found, the payment record is sent to the rejection file. On the other hand, if it cannot be verified that the merchant is set up, the consumer pay table 38 is updated to add the new merchant record and if the merchant record does not already exist, the merchant record will be created on the master merchant file database (MMF) 42, as described on page 8, lines 10-17. Right very carefully avoids any suggestion that if the validation process cannot verify that the merchant is set up, the payment request will be sent to the reject file.

Hence, what is disclosed in the present application is that a consumer can request a payment at the time the consumer initially establishes merchants in the master merchant file database (MMF) 42, as described on pages 6 and 7. On the other hand, the consumer may also update the master merchant file database (MMF) 42 to include an additional merchant at the time of requesting a payment, as described on pages 8 and 9.

Accordingly, it is respectfully requested that the rejection under 35 USC §112, first paragraph, be reconsidered and withdrawn.

Claims 36-50 stand rejected under 35 USC §102(e), as anticipated by Landry (U.S. Patent No. 5,956,700). The rejection is respectfully traversed.

In view of the above traversal of the denial of the claim for priority, it is respectfully submitted that the present application has a priority date of July 25, 1991. Accordingly the applied Landry reference is not prior art under 35 USC §102(e). Therefore, it is respectfully requested that the rejection be reconsidered and withdrawn.

In view of the foregoing, it is respectfully submitted that the application is in

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condition for allowance and an early indication of the same is courteously solicited. The Examiner is respectfully requested to contact the undersigned by telephone at the below listed local telephone number, in order to expedite resolution of any remaining issues and further to expedite passage of the application to issue, if any further comments, questions or suggestions arise in connection with the application.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 01-2135 and please credit any excess fees to such deposit account.

Respectfully submitted,

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Enclosures: Appendix  
Exhibits A-S



**DIFFERENCES IN THE BACKGROUND AND SUMMARY OF THE INVENTION,  
DESCRIPTION OF PREFERRED EMBODIMENT(S), AND FIGURES BETWEEN  
U.S. PAT. APP. SER. NO. 07/736,071 AND EACH OF U.S. PAT. NO. 5,383,113,  
U.S. PAT. APP. SER. NO. 08/372,620, U.S. PAT. NO. 5,873,072, U.S. PAT. APP.  
SER. NO. 09/250,675, AND U.S. PAT. APP. SERIAL NO. 09/540,011**

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**GROUP 3600**

United States Patent Application Serial No. 09/540,011 claims benefit of the filing date of United States Patent No. 5,383,113 through a series of Continuation Applications. The '011 Continuation Application contains slight differences from the '113 Patent. The following analysis details all changes to the '113 Patent arising throughout the prosecution of the '113 Patent and each of the Continuation Applications throughout the series of Continuation Applications. As will be seen, none of these changes add new matter to the '113 Patent.

**The First Application**

Exhibit A, found at tab 1, is a copy of a Specification as originally filed on July 25, 1991 as a part of an Application for Patent. The United States Patent and Trademark Office assigned this Application a Serial Number of 07/736,071. The copy of the '071 Specification included in Exhibit A is the copy as found in the File History of the '113 Patent. The 07/736,071 Application eventually matured into United States Patent No. 5,383,113 on January 17, 1995.

Exhibit B, found at tab 2, is a copy of Figures as originally filed with the 07/736,071 Application.

Exhibit C, found at tab 3, is a copy of the 5,383,113 Patent.

The text of the published '113 Patent differs from the text of the '071 Application filed July 24, 1991. Differences in text between the '071 Specification and the '113 Patent are due to both amendments made during the prosecution of the '071 Application and publishing errors committed at the time of the printing of the '113 Patent.

Exhibit D, found at tab 4, is a copy of a first amendment, dated April 2, 1993,

filed by applicants' counsel, requesting several changes be made to the '071 Specification. The copy of the Amendment included in Exhibit D is the copy as found in the File History of the '113 Patent. The Amendment of Exhibit D will be referred to as Amendment A.

Exhibit E, found at tab 5, is a copy of a second Amendment, dated December 28, 1998, filed by applicants' counsel requesting still more changes be made to the '071 Specification. The copy of the Amendment included in Exhibit E is the copy as found in the File History of the '113 Patent. The Amendment of Exhibit E will be referred to as Amendment B.

Under 35 USC 132 an Application can be amended as long as new matter is not inserted into the Application. If amended matter is supported by the originally filed Application, the amended matter is not new matter. Schering Corp. v. Amgen Inc., 222 F.3d 1347, 1352, 55 USPQ 2d 1650, 1653-1654 (Fed. Cir. 2000). Stated another way, matter is not new unless it discloses "an invention, process or apparatus not theretofore described." Triax Co. v. Hartman Metal Fabricators, Inc., 479 F.2d 951, 956-957, 178 USPQ 142, 146 (2<sup>nd</sup> Cir. 1973). Thus, a rewording of a passage where the same meaning remains intact does not constitute new matter. In re Anderson, 176 USPQ 331 (CCPA 1973). Also, correction of an obvious error does not constitute new matter where one skilled in the art would not only recognize the existence of error in the Specification, but also the appropriate correction. In re Oda, 170 USPQ 260 (CCPA 1971).

The changes to the as-filed '071 Specification resulting from Amendment A and Amendment B do not introduce any new matter into the as-filed '071 Specification. The '071 Specification with the changes of Amendment A and Amendment B will be referred to as the as-amended '071 Specification. The exact same invention is disclosed in the as-filed '071 Specification and in the as-amended '071 Specification. Each of the changes of Amendment A and Amendment B will be discussed below.

Amendment A modified the title in response to an examiner objection contained in a first Office Action, included herein as Exhibit F and found at tab 6, dated November 2, 1992. The title recited in the as-filed '071 Specification reads: "APPARATUS FOR AND METHOD OF BILL PAYMENT". The Examiner objected that the as-filed title was not descriptive. Amendment A requested that the title be

amended to read: "COMPUTERIZED BILL PAYMENT SYSTEM AND METHOD". As will be recognized from a reading of the as-filed '071 Specification, the disclosed invention is clearly directed to computerized bill payment. While the term "system" is not present in the title of the as-filed '071 Specification, that term does appear throughout the as-filed '071 Specification, such as, for example, at page 4, line 6. Accordingly, the amendment to the title does not introduce any new matter to the as-filed '071 Specification.

Amendment A also made several other changes to the as-filed '071 Specification, each minor in nature. On page 1, line 15, a comma was removed. The as-filed '071 Specification reads: "Consumers have used other ways to pay bills, including, personally visiting the billing entity to make a cash payment". The as-amended '071 Specification reads: "Consumers have used other ways to pay bills, including personally visiting the billing entity to make a cash payment". The removal of the comma following the term "including" obviously does not add new matter. Rather, this is merely an editorial change.

On page 2, lines 4 and 5, Amendment A resulted in text being underlined and a word being added. The as-filed '071 Specification reads: "(i.e., bank, credit union, savings and loan, etc.)" The as-amended '071 Specification reads: "(i.e., bank, credit union, savings and loan association, etc.)" The underlining of "i.e." was merely an editorial change that does not change the meaning of the phrase. The addition of the word "association" likewise does not change the meaning of the phrase. It is well known that a particular type of financial institution that takes deposits, issues dividends on deposits, and lends funds is referred to both as a "savings and loan" and a "savings and loan association." Thus, addition of "association" is not new matter.

On page 2, lines 11 and 17, the sentence "The banks that do provide that type of service are limited in that they only provide the service for their own customers..." was changed by Amendment A to "The banks that do provide that type of service are limited in that they provide the service only for their own customers...". The moving of the term "only" is an editorial change that does not add any new matter.

On page 3, line 2, the word "the" was added before the word "bill" by Amendment A. This does not in any way add new matter, especially as the term "bill" is recited prior to the instance of "bill" on page 3, line 2.

On page 3, lines 2-4, a comma was removed. The as-filed '071 Specification reads: "The present invention provides a computerized system by which a consumer may pay bills utilizing the telephone, a computer terminal, or other electronic, data transmission means". The as-amended '071 Specification reads: "The present invention provides a computerized system by which a consumer may pay bills utilizing the telephone, a computer terminal, or other electronic data transmission means". The removal of the comma after the term "electronic" merely corrects an obvious grammatical error and does not add new matter to the as-filed '071 Specification.

On page 3, line 14, Amendment A modified the phrase "push button" to read "push-button". This grammatical change does not in any way change the meaning of the phrase, and thus does not add new matter.

On page 4, line 21, the phrase "...information to input into the..." was modified to read "...information to be input into...". The addition of "be" does not change the meaning of the referenced text. Again, this change is merely editorial in nature, not adding new matter to the as-filed '071 Specification.

On page 4, line 23, Amendment A modified the sentence "This information may include the consumer's name, address, telephone and other applicable information" to read: "This information may include the consumer's name, address, telephone number and other applicable information". This corrects an obvious editorial error in the as-filed '071 Specification, the lack of "number". In no way does the addition of the word "number" add new matter to the as-filed '071 Specification.

On page 5, line 10-12, the sentence "As explained hereinafter, the service provider may be at risk when paying consumers' bills by check written on the service provider's account" was modified by Amendment A to read: "As explained hereinafter, the service provider may be at risk when paying a consumer's bill by check written on the service provider's account". Both the as-filed sentence and the as-amended sentence explain the concept of risk when paying a bill on behalf of another. The as-filed sentence is cast in the plural, whereas the as-amended sentence is cast in the singular. This in no way changes the risk being explained. Rather, this is merely an editorial change. The change to the sentence does not introduce new matter into the disclosure of the as-filed '071 Specification.

On page 5, lines 14-16, the phrase "...since there is a slight chance the

consumer may not reimburse the service provider once the provider has already made payment" was modified to read: "...since there is a slight chance the consumer may not reimburse the service provider after the provider has already made payment". This phrase, like the sentence discussed immediately above, explains risk. The amendment of the word "once" to "after" in no way changes the meaning of the sentence in which this phrase appears. Thus, this amendment does not result in the addition of new matter.

On page 5, line 20, Amendment A changed the word "institution's" to "institutions". This change corrects an obvious grammatical error and does not add new matter to the as-filed '071 Specification.

On page 6, line 17-20, the sentence "The default credit limit amounts over which the service provider may be unwilling to assume financial risk may be modified based on the information obtained from the credit report 30" was modified to read: "The default credit limit amount over which the service provider may be unwilling to assume financial risk may be modified based on the information obtained from the credit report 30". Thus, 'credit limit amounts' was changed to the singular, 'credit limit amount'. The as-filed '071 Specification discloses both a single credit limit amount and multiple credit limit amounts. For example, at page 14, lines 3-5, the as-amended '071 Specification recites: "If a payment amount is greater than the consumer's credit limit, ...". And, the example on page 15, line 5, through page 18, line 3 discloses comparing payment amounts associated with a single consumer to multiple credit limits. Thus, the amendment to the sentence of page 6, lines 17-20, is an editorial change that does not in any way add new matter to the as-filed '071 Specification.

On page 6, line 24, the phase "merchants name" was modified to read "merchant's name". This corrects an obvious grammatical error and does not add new matter.

On page 7, line 7, another editorial change was made by Amendment A. The phrase "...most consumers pay, such as, department stores, the electronic company..." was changed to "...most consumers pay, such as department stores, the electric company...". The deletion of the comma following the phrase "such as" does not add new matter to the invention disclosed in the as-filed '071 Specification.

On page 7, line 14, still another editorial change was made by removal of

another comma. Again, the deletion of the comma following “such as” does not add new matter to the invention disclosed in the as-filed ‘071 Specification.

On page 7, line 25, yet another comma was removed by Amendment A. This deletion of the comma following “computer” also does not add new matter to the invention disclosed in the as-filed ‘071 Specification.

On page 8, lines 4-6, the sentence “On a personal computer a consumer may enter merchant payment amounts and payment dates on the computer screen then transmit this information to the service provider” was modified to read “A consumer may enter merchant payment amounts and payment dates on the computer screen then transmit this information to the service provider”. The meaning of the sentence was not changed by Amendment A, as “computer screen” is still recited in this sentence, a consumer is necessarily entering information “on a computer”. Deletion of “On a personal computer” is an obvious editorial change that does not add new matter to the as-filed ‘071 Specification.

On page 8, line 21, yet another editorial change was made. The sentence reading “This may be accomplished by assigning each month a number, such as January being month 01; February – month 02; etc.” was amended to read “This may be accomplished by assigning each month a number, such as January being month 01 February being month 02; etc.” Clearly, this addition of “being” does not introduce new matter to the as-filed ‘071 Specification.

On page 10, line 16, an acronym included in the as-filed ‘071 Specification was spelled out. In particular, the as-filed ‘071 Specification recites: “Federal Reserve ACH Network”. The as-amended ‘071 Specification recites: “Federal Reserve Automated Clearing House (ACH) Network”. This does not add new matter to the invention disclosed in the as-filed ‘071 Specification, as “ACH” is defined in the as-filed ‘071 Specification, at page 12, line 4, as Automated Clearing House.

On page 10, lines 22 and 23, an editorial change made the term “check” plural. The as-filed ‘071 Specification recites: “Additionally, an IBM Laser Printer attached to a Troy micr post printer 48 may be used by the service provider to send drafts 76 or consolidated check 78 (check made payable to a single merchant to cover payments for a number of consumers who all owe the same merchant) to merchants.” The as-amended ‘071 Specification recites: “Additionally, an IBM Laser Printer attached to a Troy micr post printer 48 may be used by the service provider to

send drafts 76 or consolidated checks 78 (checks made payable to a single merchant to cover payments for a number of consumers who all owe the same merchant) to merchants.” This editorial change merely makes the term “check” plural, to match the plural term “drafts”. This does not add new matter to the invention disclosed in the as-filed ‘071 Application.

On page 11, lines 10-11, the sentence “The payment process cycle may be initiated 56, each day or more or less frequently” appearing in the as-filed ‘071 Specification was amended to read: “The payment process cycle 56 may be initiated each day, or more or less frequently”. The movement of the number “56” and addition of the comma after “day” are merely editorial changes that do not change the meaning of the sentence. These changes do not add new matter to the invention disclosed in the as-filed ‘071 Specification.

On page 12, line 4, the phrase “automated clearing house” recited in the as-filed ‘071 Specification was deleted by Amendment A. The as-filed sentence reads: “Assigned factors determine if a payment will be released as a paper item, or an ACH electronic transaction (automated clearing house; service provider is a party to transaction).” The amended sentence reads: “Assigned factors determine if a payment will be released as a paper item, or an ACH electronic transaction (service provider is a party to transaction).” This change goes along with the change to page 10, line 16, discussed above. As the amendment to page 10, line 16, defines ACH as Automated Clearing House, the definition is no longer needed at page 12, line 4. Thus, the deletion of the term is an editorial change that certainly does not add new matter to the invention disclosed in the as-filed ‘071 Specification.

On page 12, line 8, yet another comma was removed by Amendment A. This deletion of the comma after “60” does not add new matter to the invention disclosed in the as-filed ‘071 Specification.

On page 12, line 24, another editorial change was made by Amendment A. The as-filed ‘071 Specification reads: “(i.e. ...)”. The as-amended ‘071 Specification reads: “(i.e., ...)”. The addition of underlining and a comma does not add new matter to the invention disclosed in the as-filed ‘071 Specification.

On page 13, line 5, the phrase “Federal Law” appearing in the as-filed ‘071 Specification was changed to read “federal law.” This grammatical change does not add new matter to the invention disclosed in the as-filed ‘071 Specification.

On page 13, line 8, the sentence “The third manner in which the service provider may pay bills is by check written on the service provider’s account” recited in the as-filed ‘071 Application was changed by Amendment A to recite: “The third manner in which the service provider may pay bills is by a check written on the service provider’s account”. The addition of the word “a” before the word “check” is an editorial change that does not add new matter to the invention disclosed in the as-filed Specification.

On page 13, line 17, the phrase “check, limit” appearing in the as-filed ‘071 Specification was amended to recite: “credit limit”. When read in context with the sentence preceding the sentence in which this phrase appears, it is clear this is a change that corrects an editorial error in the as-filed ‘071 Specification. The preceding sentence reads: “As a means of minimizing risk to the service provider, any transaction may be compared to the MMF 42 *credit* limit”. (emphasis added). The term “check” was changed to “credit” be in accord with the term “credit” as appearing in the preceding sentence. The comma is removed for obvious grammatical reasons. Accordingly, this change does not add new matter to the invention disclosed in the as-filed ‘071 Specification.

On page 13, line 22, still another editorial change was made. The as-filed ‘071 Specification reads: “...the payment may be released as electronic 74 or check 78”. The as-amended Specification reads: “the payment may be released as an electronic payment 74 or check 78”. The change to “an electronic payment” from “electronic” clearly does not add new matter to the as-filed ‘071 Specification.

On page 14, line 4, another editorial correction, related to the correction of page 13, line 17, discussed above (that does not add new matter to the as-filed ‘071 Specification) was made by Amendment A. Again, the phrase “check limit” was changed by Amendment A to “credit limit.”

On page 14, lines 14-19, the sentences “For example, a merchant set up with a settlement code ‘01’ results in a check and remittance list 78 mailed to the merchant. Merchants with a settlement code, such as, ‘10’ produce an ACH customer initiated entry (CIE). Merchants with a settlement code, such as, ‘13’ produce a remittance processing system (RPS) credit.” appear in the as-filed ‘071 Specification. Amendment A changed these sentences to read: “For example, a merchant set up with a settlement code ‘01’ results in a check and remittance list 78

being mailed to the merchant. Merchants with a settlement code such as '10' produce an ACH customer initiated entry (CIE). Merchants with a settlement code such as '13' produce a remittance processing system (RPS) credit." The addition of the term "being" and the deletion of the commas are clearly editorial changes that do not result in new matter being added to the as-filed '071 Specification.

On page 14, line 24, the as-filed '071 Specification reads: "For variable payments, once made they are deleted on the consumer pay table". Amendment A changed this to read: "For variable payments, once made the payment date is deleted from the consumer pay table".

This does not add new matter to the invention disclosed in the as-filed '071 Specification. The as-filed '071 Specification explicitly recites that a variable payment is removed from the pay table after payment is made. The as-filed '071 Specification defines 'variable' at page 7, lines 11-13, as a payment that varies in date and amount from payment instance to payment instance. Use of the term 'payment' on page 14, line 24, clearly and necessarily refers to an order to make payment, which includes a payment date and payment amount. Thus, the sentence found on page 14, line 24, in the as-filed '071 Specification teaches that an order for payment is removed from the pay table once the order is executed, e.g., once the payment is made.

The as-amended '071 Specification does not explicitly recite that the payment (order for payment) be removed from the pay table after the payment is made. Rather, the as-amended '071 Specification recites that that the payment date is removed from the pay table. Because the payment date is a part of the order for payment, removal of the payment date effectively removes the order for payment from the pay table. Thus, the as-amended sentence has the same meaning as the as-filed sentence. Accordingly, this change does not constitute new matter.

On page 15, line 7, an obvious spelling error was corrected by Amendment A. The term "Fegures" was changed to "Figures". This assuredly does not introduce new matter into the as-filed '071 Specification.

On page 15, line 20, on page 16, lines 21 and 23, and on page 17, line 22, yet other commas were removed from the as-filed '071 Specification by Amendment A. These instances of removal of commas, as with the other instances of comma removal, do not introduce new matter into the as-filed '071 Specification.

Amendment B further modified the title in response to an examiner objection contained in a second Office Action, included herein as Exhibit G and found at tab 7, dated June 17, 1993. The Examiner suggested the title of "SYSTEM AND METHOD FOR ELECTRONICALLY PROVIDING CUSTOMER SERVICES INCLUDING PAYMENT OF BILLS, FINANCIAL ANALYSIS, AND LOANS". Amendment B changes the title to that suggested by the Examiner in the second Office Action. This Examiner-requested change certainly does not introduce new matter.

Also in the second Office Action, the Examiner requested that page 10, line 21, of the as-filed '071 Specification be amended to recite "micr post processor 48", instead of "Troy micr post printer 48". Through Amendment B, applicants' complied with the Examiner's request. Again, this Examiner-requested change does not introduce new matter.

As shown in the above discussion, none of the amendments made to the Specification of the as-filed '071 Application introduce new matter to the as-filed '071 Application.

The changes requested by Amendment A and Amendment B, discussed above, were entered into the file by United States Patent and Trademark Office as evidenced by the face of the copy of the as-filed '071 Specification included as Exhibit A, by the face of the copy of Amendment A included as Exhibit D, and by the face of the copy of Amendment B included as Exhibit E. As such, the changes of Amendment A and Amendment B became an official part of the as-filed '071 Specification. Because of entry by the United States Patent and Trademark Office, the text of the as-amended '071 Specification should be the same as the text of the as-published '113 Patent. However, due to publishing errors, the text differs.

The first difference between the as-amended '071 Specification and the '113 Patent is found in the abstract of the as-published '113 Patent. The as-published '113 abstract reads, at line 3: "...telecommunications; means to...". The as-filed Specification reads, at page 26, line 5, "...telecommunications means to...".

The second difference between the as-amended '071 Specification and the '113 Patent is found at column 1, line 34, of the as-published '113 Patent and at page 2, line 4, of the as-amended '071 Specification. The as-amended '071 Specification reads: "(i.e., bank, credit union, savings and loan association, etc.)" The as-published '113 Patent reads: "(i.e., bank, credit union, savings and loan

association, etc.)"

The third difference between the as-amended '071 Specification and the as-published '113 Patent is found at column 2, line 3, of the as-published '113 Patent and at page 3, line 12, of the as-amended '071 Specification. The as-amended '071 Specification reads: "e.g.". The as-published '113 Patent reads: "e.g.".

The fourth difference between the as-amended '071 Specification and the as-published '113 Patent is found at column 2, line 38, of the as-published '113 Patent and at page 4, line 16, of the as-amended '071 Specification. The as-amended '071 Specification reads: "Figure". The as-published '113 Patent reads: "Fig.".

The fifth difference between the as-amended '071 Specification and the as-published '113 Patent is found at column 2, line 44, of the as-published '113 Patent and at page 4, line 21, of the as-amended '071 Specification. The as-amended '071 Specification reads: "...information to be input into...". The as-published '113 Patent reads: "...information to be put into...".

The sixth difference between the as-amended '071 Specification and the as-published '113 Patent is found at column 2, line 50, of the as-published '113 Patent and at page 5, line 3, of the as-amended '071 Specification. The as-amended '071 Specification reads: "...input via keyboard...". The as-published '113 Patent reads: "...input via a keyboard...".

The seventh difference between the as-amended '071 Specification and the as-published '113 Patent is found at column 3, line 30, of the as-published '113 Patent and at page 6, line 21, of the as-amended '071 Specification. The as-amended '071 Specification reads: "Figure". The as-published '113 Patent reads: "FIG.".

The eighth difference between the as-amended '071 Specification and the as-published '113 Patent is found at column 4, line 42, of the as-published '113 Patent and at page 7, line 7, of the as-amended '071 Specification. The as-amended '071 Specification reads: "...the usual merchants most...". The as-published '113 Patent reads: "...the usual men, chants most...".

The ninth difference between the as-amended '071 Specification and the as-published '113 Patent is found at column 3, line 55, of the as-published '113 Patent and at page 7, line 18, of the as-amended '071 Specification. The as-amended '071 Specification reads: "e.g.". The as-published '113 Patent reads: "e.g.".

The tenth difference between the as-amended '071 Specification and the as-published '113 Patent is found at column 3, line 61, of the as-published '113 Patent and at page 7, line 23, of the as-amended '071 Specification. The as-amended '071 Specification reads: "i.e.". The as-published '113 Patent reads: "i.e.".

The eleventh difference between the as-amended '071 Specification and the as-published '113 Patent is found at column 3, line 68, of the as-published '113 Patent and at page 8, line 5 of the as-amended '071 Specification.. The as-amended '071 Specification reads: "payment dates." The as-published '113 Patent reads: "pavement dates."

The twelfth difference between the as-amended '071 Specification and the as-published '113 Patent is found at column 4, line 19, of the as-published '113 Patent and at page 8, line 21, of the as-amended '071 Specification. The as-amended '071 Specification reads: "02; etc." The as-published '113 Patent reads: "02; etc."

The thirteenth difference between the as-amended '071 Specification and the as-published '113 Patent is found at column 4, line 29, of the as-published '113 Patent and at page 9, line 5, of the as-amended '071 Specification. The as-amended '071 Specification reads: "Figure". The as-published '113 Patent reads: "FIG.".

The fourteenth difference between the as-amended '071 Specification and the as-published '113 Patent is found at column 4, line 45, of the as-published '113 Patent and at page 9, line 20, of the as-amended '071 Specification. The as-amended '071 Specification reads: "...duplicate payments...". The as-published '113 Patent reads: "...duplicate pavements...".

The fifteenth difference between the as-amended '071 Specification and the as-published '113 Patent is found at column 4, line 60, of the as-published '113 Patent and at page 10, line 7, of the as-amended '071 Specification. The as-amended '071 Specification reads: "Figure". The as-published '113 Patent reads: "FIG.".

The sixteenth difference between the as-amended '071 Specification and the as-published '113 Patent is found at column 5, line 23, of the as-published '113 Patent and at page 11, line 9, of the as-amended '071 Specification. The as-amended '071 Specification reads: "Figures". The as-published '113 Patent reads: "FIGS.".

The seventeenth difference between the as-amended '071 Specification and the as-published '113 Patent is found at column 5, line 42, of the as-published '113 Patent and at page 11, line 26, of the as-amend '071 Specification. The as-amended '071 Specification reads: "...the pay table 38." The as-published '113 Patent reads: "...the Day table 38."

The eighteenth difference between the as-amended '071 Specification and the as-published '113 Patent is found at column 5, line 46, of the as-published '113 Patent and at page 12, line 4, of the as-amended '071 Specification. The as-amended '071 Specification reads: "transaction (service". The as-published '113 Patent reads: "transaction service".

The nineteenth difference between the as-amended '071 Specification and the as-published '113 Patent is found at column 6, line 1, of the as-published '113 Patent and at page 12, line 24, of the as-amended '071 Specification. The as-amended '071 Specification reads: "i.e..". The as-published '113 Patent reads: "i.e.".

The twentieth difference between the as-amended '071 Specification and the as-published '113 Patent is found at column 6, line 7, of the as-published '113 Patent and at page 13, line 5, of the as-amended '071 Specification. The as-amended '071 Specification reads: "...federal law...". The as-published '113 Patent reads: "...federal Law...".

The twenty-first difference between the as-amended '071 Specification and the as-published '113 Patent is found at column 6, line 60, of the as-published '113 Patent and at page 15, line 2, of the as-amended '071 Specification. The as-amended '071 Specification reads: "...process date...". The as-published '113 Patent reads: "...princess date...".

The twenty-second difference between the as-amended '071 Specification and the as-published '113 Patent is found at column 6, line 65, of the as-published '113 Patent and at page 15, line 7, of the as-amended '071 Specification. The as-published '113 Patent reads: "...in FIGS. 4A, B, C." The as-amended '071 Specification reads: ...in Figures 4A, B, C."

The twenty-third difference between the as-amended '071 Specification and the as-published '113 Patent is found at column 7, line 17, of the as-published '113 Patent and at page 15, line 25, of the as-amended '071 Specification. The as-published '113 Patent reads: "1000.00." The as-amended '071 Specification reads:

"1,000.00."

The twenty-fourth difference between the as-amended '071 Specification and the as-published '113 Patent is found at column 7, line 27, of the as-published '113 Patent and at page 16, line 9, of the as-filed '071 Specification. The as-published '113 Patent recites: "will be said without". The as-amended '071 Specification recites: "will be paid without".

The twenty-fifth difference between the as-amended '071 Specification and the as-published '113 Patent is found at column 7, line 43, of the as-published '113 Patent and at page 16, line 23, of the as-amended '071 Specification. The as-published '113 Patent reads: "...therefore, go...". The as-amended '071 Specification reads: "...therefore go...".

The twenty-sixth difference between the as-amended '071 Specification and the as-published '113 Patent is found at column 8, line 10, of the as-published '113 Patent and at page 17, lines 22-23 , of the as-amended '071 Specification. The as-published '113 Patent reads: "...example, fails...". The as-amended '071 Specification reads: "...example fails...".

With reference to Exhibit B, the '071 Application was-filed with seven Figures, Figure 1, Figure 2, Figure 3, Figure 4a, Figure 4b, Figure 4c, and Figure 5. Exhibit H, found at tab 8, is a copy of a draftsman approval of the as-filed '071 Figures, dated September, 24, 1991. With reference to Exhibits C, the '113 Patent was also published with the seven approved Figures, Figures, Figure 1, Figure 2, Figure 3, Figure 4a, Figure 4b, Figure 4c, and Figure 5.

Exhibit I, found at tab 9, is a side-by-side comparison of each of the as-filed Figures of the '071 Application with the as-published Figures of the '113 Patent. As evidenced by Exhibit I, each of the Figures published in the '113 Patent is the same as the corresponding Figure in the as-filed '071 Patent Application which matured into the '113 Patent.

## The Second Application

Exhibit J, found at tab 10, is a copy of a Specification as originally filed on January 13, 1995 as a part of a Continuation Application for Patent claiming priority to the filing date of the 5,383,113 Patent. The United States Patent and Trademark

Office assigned this Continuation Application a Serial Number of 08/372,620. The 08/372,620 Continuation Application eventually matured into United States Patent No. 5,873,072 on February 16, 1999.

Exhibit K, found at tab 11, is a copy of Figures as originally filed with the 08/372,620 Continuation Application.

Exhibit L, found at tab 12, is a copy of Formal Drawings for the 08/372,620 Continuation Application filed on September 30, 1998 during the prosecution of the 08/372,620 Continuation Application.

Exhibit M, found at tab 13, is a copy of the 5,873,072 Patent.

35 USC 120 governs Continuation Applications. For a later filed Application to obtain benefit of the filing date of an earlier filed Application, four conditions must be met. First, the claims of the later filed Application must be directed to an invention disclosed in the earlier filed Application. Second, the later filed Application must be filed during the pendency of the earlier filed Application. Third, the later filed Application must make specific reference to the earlier filed Application. And fourth, the later filed Application must be filed by at least one inventor of the earlier filed Application.

Under 35 USC 120 a later filed Application should not include new matter. However, there is no requirement under 35 USC 120 that the later filed Application have the exact same disclosure as an earlier filed Application to obtain the filing date of the earlier filed Application. Later filed Applications that include new matter are Continuation-In-Part Applications. Claims in a Continuation-In-Part Application that are directed to subject matter disclosed in an earlier filed Application are entitled to the filing date of the earlier filed Application, while claims in a Continuation-In-Part Application that are directed to subject matter added in the Continuation-In-Part Application (the new matter) are not entitled to the filing date of the earlier filed Application, but the actual filing date of the Continuation-In—Part Application. Augustine Medical, Inc. v. Gaymar Industries Inc., 181 F.2d 1291, 1302, 50 USPQ2d 1900, 1908 (Fed. Cir. 1999).

The as-filed '620 Continuation Application claims matter disclosed in the '071 Application, was filed before the '071 Application issued, makes specific reference to the '071 Application, and names all the inventors of the '071 Application as inventors.

With reference to Exhibits A and J, the as-filed '620 Specification differs

slightly from both the as-filed '071 Specification and the as-amended '071 Specification. However, none of these slight differences constitute new matter beyond that disclosed in the '071 Application.

The as-filed '620 Specification includes a Related Application section making specific reference to the '071 Application, as required. Obviously, the '071 Specification does not include a Related Application section. The new section recites that the '620 Application is a Continuation of the '071 Application.

The Related Application section also includes an incorporation-by-reference statement explicitly incorporating the entirety of the '071 Application. An incorporation-by-reference statement makes subject matter included in an incorporated reference a part of the Application in which the incorporation-by-reference statement appears. Mendenhall v. Astec Industries Inc., 13 USPQ2d 1913, 1922 (E.D. Tenn. 1988), aff'd 887 F.2d 1094, 13 USPQ2d 1956 (Fed. Cir. 1989). That is, the Application should be read as including the incorporated reference. Further, an incorporation-by-reference statement enables an applicant to amend a Continuation Application, without Petition, to include any subject matter in a prior Application specifically incorporated by reference. See MPEP 608.01(p).

As for the remaining differences between the '071 Application and the '620 Continuation Application, the first sentence of the Background And Summary Of The Invention section of the as-filed '620 Specification differs from the first sentence of the Background And Summary Of The Invention section of both the as-filed and as-amended '071 Specification. Page 1, lines 3-4, of the '071 Specification reads: "The present invention relates generally to a payment system for and method of paying bills". Page 1, line 9, of the as-filed '620 Specification reads: "The present invention relates generally to apparatus and methods for paying bills."

This first sentence of the '620 Specification introduces "apparatus and methods", while the first sentence of the '071 Specification introduces "a payment system" and "method". Thus, the as-filed '620 replaces "system" with "apparatus".

As for the removal of "system" from this first sentence, the '071 Specification and the '620 Specification are each replete with references to a system. Particularly, the second sentences of both the '071 Application and '620 Continuation Application recite: "More particularly, the present invention is a computerized system..." Thus, removal of the term "system" from the first sentence does not add new matter to the

invention disclosed in the '071 Application. Further, because of the incorporation-by-reference statement, the '620 Specification includes all the disclosure of the '071 Specification, including a "system".

As for the addition of "apparatus" to the first sentence, the title of the as-filed '071 Specification reads: "APPARATUS FOR AND METHOD OF BILL PAYMENT". Also, page 18, lines 4-6, of both the as-filed and as-amended '071 Specification reads: "The apparatus for and method of bill payment of the present invention and many of its attendant advantages will be understood from the foregoing description". Thus, an apparatus for bill payment is disclosed in the '071 Application. Accordingly, this difference between the first sentences does not constitute the addition of new matter.

The second sentence of the Background And Summary Of The Invention section of the as-filed '620 Specification also differs from the first sentence of the Background And Summary Of The Invention section of the as-filed and as-amended '071 Specification. Page 1, lines 4-10, of both the as-filed and as-amended '071 Specification reads: "More particularly, the present invention is a computerized system for paying bills or making other payments whereby a consumer may contact a single source from a remote location via a telephone, a computer terminal with modem, or other electronic means, to direct the single source to pay the consumer's bills instead of the consumer writing checks for each bill".

Page 1, lines 10-13, of the as-filed '620 Specification reads: "More particularly, the present invention is a computerized system for paying bills whereby a consumer may contact a single source from a remote location via a telephone, a computer terminal with modem, or other electronic means, to direct the single source to pay the consumer's bills instead of the consumer writing checks for each bill".

The as-filed '062 Specification lacks the language "or making other payments". The exclusion of this language certainly does not add new matter. Further, exclusion of "or making other payments" in no way constitutes new matter. Both the as-filed '620 Specification and the as-filed and as-amended '071 Specification include the text "The term 'merchant' as used herein is intended to pertain to any person or entity that the consumer wishes to pay and is not to be limited to the usual merchants most consumers pay...". Thus, the making of payments other than bill payments is still disclosed in the as-filed '620 Specification

even though the language “or making other payments” is not found in the as-filed ‘620 Specification at page 1, lines 10-13. Furthermore, because of the incorporation-by-reference statement, the ‘620 Specification should be read as including everything disclosed in the ‘071 Specification, including the making of “other” payments besides bill payments

The reference in the as-filed ‘620 Specification to an appendix submitted with the filing of the ‘071 Application differs from the reference to the appendix found in the as-filed and as-amended ‘071 Specification. The ‘071 Specification, reads at page 1, lines 10-12: “An appendix is submitted with this Specification which contains the program code of the present invention”. The as-filed ‘620 Specification, at page 1, lines 13-17, reads: “A microfiche appendix has been submitted with the parent case of this Application Serial No. 07/736071 which is to issue as United States Letters Patent No. 5,383,113 on January 17, 1995 which contains the program code of the present invention and which in its entirety is incorporated herein by reference. An additional hard copy of the appendix is attached as Exhibit A.”

An Amendment, labeled Exhibit O found at tab 15, dated December 4, 1996, made during the prosecution of the ‘620 Continuation Application modified the as-filed sentence to read, “A microfiche appendix has been submitted with the parent case, Application Serial No. 07/736071, now issued as United States Letters Patent No. 5,383,113 on January 17, 1995 which contains the program code of the present invention and which in its entirety is incorporated herein by reference. An additional hard copy of the appendix is attached as Exhibit A.” This Amendment merely more accurately references the ‘113 Patent.

As evidenced by the face of the Amendment of December 4, 1996 and the face of the as-filed ‘620 Specification, the United States Patent and Trademark Office entered this amendment. However, the as-published ‘072 Patent differs slightly from the as-filed and as-amended ‘620 Specification. At column 1, lines 24-29, the ‘072 Patent reads: “A microfiche appendix has been submitted with the parent case, Application Ser. No. 07/736,071, now issued as U.S. Pat. No. 5,383,113 on Jan. 17, 1995 which contains the program code of the present invention and which in its entirety is incorporated herein by reference. An additional hard copy of the appendix is attached as exhibit A”. The differences in the as-published ‘072 Patent are merely abbreviations of terms. These differences between

the as-filed and as-amended '071 Specification and the as-filed '620 Specification, as well as the as-amended '620 Specification and the as-published '072 Patent relating to the '071 Application, clearly do not constitute new matter.

Page 1, lines 13-14, of both the as-filed and as-amended '071 Specification recites: "It has been common for many years for consumers to pay bills by way of a personal check...". Page 1, lines 18-19, of the as-filed '620 Specification recites: "It has been common for many years for consumers to pay monthly bills by way of a personal check...". Thus, the '620 Specification includes the phrase "to pay monthly bills", whereas the '071 Specification only recites: "to pay bills".

The addition of the word "monthly" does not add new matter. As will be recognized from the discussion above, the invention disclosed in the as-filed '071 Specification enables a consumer to pay monthly bills, such as an bill for electric service, as well as to make other types of payments. Payment of monthly bills is disclosed in the '071 Application, as well as obviously within the as-filed '620 Specification. As an example, the as-filed and as-amended '071 Specification as well as the as-filed '620 Specification include the text "...it is not unusual for a consumer to have several regular monthly invoices to pay." It will be appreciated that a "regular monthly invoice" is the same as a "monthly bill".

The term "expense" is found in the as-filed and as-amended '071 Specification at page 1, line 22, in the sentence "Writing individual checks to pay each invoice can be time-consuming and costly due to postage and other related expense". In the as-filed '620 Specification the term "expense", found at page 2, line 5, is made plural. The as-filed '620 Specification reads: "Writing individual checks to pay each invoice can be time-consuming and costly due to postage and other related expenses." Making the term "expense" plural does not in any way change the meaning of the sentence. Clearly, this is not new matter.

At page 4, line 9, the as-filed '620 Specification includes a sentence not included in the as-filed or as-amended '071 Specification. The as-filed '620 Specification recites: "The present invention works regardless of where the consumer banks". The sentence immediately preceding the added sentence reads: "Transactions are recorded against the consumer's account wherever he or she banks". This preceding sentence appears in the as-filed and as-amended Specification at page 3, lines 5-6. The added sentence is merely a restatement of

the concept taught in the preceding sentence. Thus, this sentence does not constitute new matter.

Several differences between the sentence appearing on page 3, lines 8-23, of the as-filed and as-amended '071 Specification exist at page 4, lines 10-20, of the as-filed '620 Specification.

The as-amended '071 Specification reads: "The method of the present invention includes: gathering consumer information and creating a master file with banking information and routing codes; the generation of payment instructions by the consumer at a convenient location, typically remote from the payment service provider (e.g., at home), through an input terminal such as a personal computer, a push-button telephone or other like communication means; applying the payment instructions to the consumer's file; using computer software of the present invention to examine various files to determine the appropriate form of payment based on variables involving banking institutions and merchants; validating each transaction against a dynamic credit file and routing based on set parameters; and, if after processing no flags are encountered, adjusting the consumer's account (usually by debiting) and making payment directly to the payee in accordance with the consumer instructions."

The as-filed '620 Specification reads: "The method of the present invention includes: gathering consumer information and creating a master file with banking information and routing codes; inputting payment instructions by the consumer at a convenient location (e.g., at home), typically remote from the payment service provider, by using an input terminal such as a push-button telephone; applying the payment instructions to the consumer's file; using computer software of the present invention to examine various files to determine such things as what is the appropriate form of payment based on variables involving banking institutions and merchants; comparing each transaction against a dynamic credit file and routing based on set parameters; and, if the payment system determines that everything is ready for payment to be made, adjusting the consumer's account (usually by debiting) and making payment directly to the billing entity."

For ease of understanding, the changes between the as-amended '071 Specification and the as-filed '620 Specification are highlighted in the following text. Text in strike-through is text that appears in the as-amended '071 Specification and

not the as-filed '620 Specification, and underlined text is text that appears in the as-filed '620 Specification and not the as-amended '071 Specification.

The method of the present invention includes: gathering consumer information and creating a master file with banking information and routing codes; ~~the generation of inputting~~ payment instructions by the consumer at a convenient location (e.g., at home), typically remote from the payment service provider (e.g., at home), ~~by using~~ through an input terminal such as a ~~personal computer~~, a push-button telephone ~~or other like communication means~~; applying the payment instructions to the consumer's file; using computer software of the present invention to examine various files to determine such things as what is the appropriate form of payment based on variables involving banking institutions and merchants; validating comparing each transaction against a dynamic credit file and routing based on set parameters; and, if ~~after processing no flags are encountered~~ the payment system determines that everything is ready for payment to be made, adjusting the consumer's account (usually by debiting) and making payment directly to ~~the payee in accordance with the consumer instructions~~ the billing entity.

This long sentence includes several clauses, each separated by semi-colons. The differences within each clause will be discussed together. The first clause with differences begins with "~~the generation of inputting~~" and ends with "telephone ~~or other like communication means~~". "Personal computer" and "other like communication means" do not appear in the sentence in the '620 Specification. However, use of a device besides a telephone appears in other parts of both the as-filed and as-amended '071 Specification and the as-filed '620 Specification. For example, at page 7, lines 18-20, of the as-filed and as-amended '071 Specification, and at page 7, lines 4-5, of the '620 Specification, the sentence "Through a telecommunications terminal 34 (e.g., a push-button telephone or computer terminal), a consumer may initiate payment of bills" appears. Thus, because use of devices other than a telephone is disclosed in both the '071 Application and the '620

Continuation Application, this change does not constitute new matter.

Another difference in the first clause is “the generation of” versus “inputting”. It will be recognized by one of ordinary skill in the art that this clause has the same meaning no matter whether recited with “the generation of” or “inputting”. In either clause, a consumer provides payment instructions. Thus, no new matter is introduced by this difference.

Another difference in the first clause is the placement of the phrase “(e.g., at home)”. As is clear from a reading of the sentence, the placement of this phrase in the as-filed ‘062 Specification being different than the placement of this phrase in the as-filed and as-amended ‘071 Specification does not alter the meaning of the sentence. Thus, this difference does not constitute new matter.

The final difference in the first clause is the use of the phrase “by using an input terminal” in the as-filed ‘620 Specification, and the use of the phrase “through an input terminal” in the as-filed and as-amended ‘071 Specification. The sentence has the same meaning no matter whether the version reciting “by using an” is read, or the version reciting “through an” is read. Thus, this difference does not introduce new matter.

The second clause with differences begins with “using computer software” and ends with “and merchants”. The as-filed ‘620 Specification adds the text “such things as what is”. This addition does not change the meaning of the clause. Thus, the addition does not add new matter to the invention disclosed in the as-filed and as-amended ‘071 Specification.

The third clause with differences begins with “validating comparing” and ends with “set parameters”. The only difference in this clause is between “validating” and “comparing”. This difference does not change the meaning of the clause. The acts of validation and comparison both appear throughout the as-filed and as-amended ‘071 Specification and the ‘620 Specification.

As taught, validation is achieved by comparing an item being validated to stored information. For example, page 9, lines 9-10, of the as-filed and as-amended ‘071 Specification, and page 8, lines 9-10, of the as-filed ‘620 Specification, each recite: “The consumer’s records may be edited 44 for validity by comparing to the merchants’ account scheme”. Also for example, page 9, lines 18-20, of the as-filed and as-amended ‘071 Specification and page 8, lines 15-18, of the as-filed ‘620

Specification each recite: "The payment may first go through a validation process against the pay table. The validation process checks for duplicate payments and if duplicates are found they are sent to a reject file." Comparing is a part of validating. Thus, the substitution of the word "comparing" for "validating" does not alter the meaning of the clause.

Furthermore, "comparing" each transaction is explicitly taught at Page 13, lines 15-16, of the as-filed and as-amended '071 Specification, and page 12, lines 3-4, of the as-filed '620 Specification. Each recites: "As a means of minimizing risk to the service provider, any transaction may be compared to the MMF 42 credit limit." Also, page 14, lines 1-3, of the as-filed and as-amended '071 Specification and page 12, lines 10-11, of the as-filed '620 Specification each recite: "Any transaction may be compared to the consumer's database credit limit parameters." Thus, substitution of the word "comparing" for "validating" in no way adds new matter to the invention disclosed in the '071 Application.

The final clause with differences begins with "and, if" and ends with "~~instructions~~ the billing entity." The as-filed and as-amended '071 Specification teaches that a consumer's account is adjusted "if after processing (the transaction) no flags are encountered". The as-filed '620 Specification teaches that a consumer's account is adjusted "if the payment system determines that everything is ready for payment to be made".

Page 15, lines 16-19, of the as-filed and as-amended '071 Specification and page 13, lines 17-19, of the as-filed '620 Specification each recite: "First, the consumer database 22 is edited to validate the status, banking institution, and pre-note flags associated with the consumer's requested payments" before issuing a payment. Thus, both the '071 and '620 Continuation Applications teach making payment after checking multiple flags. The recited "if the payment system determines that everything ready for payment to be made" before adjusting a consumer's account is merely a different way to state "if after processing no flags are encountered" a consumer's account is adjusted. This change does not result in a different meaning for the clause, thus does not constitute new matter.

The final clause also includes another difference. The '071 Application recites: "making payment directly to the payee in accordance with the consumer instructions". The '620 Continuation Application recites: "making payment directly to

the billing entity". The as-filed and as-amended '071 Specification and the as-filed '620 Specification each disclose making payments to payees other than billing entities. Thus, this one instance of reciting "billing entity" instead of "payee" does not add new matter to the invention recited in the '071 Application. The exclusion of the phrase "in accordance with the consumer instructions" likewise does not add new matter to the invention disclosed in the '071 Application. Both the '071 and the '620 Continuation Applications teach making payment in accordance with consumer instructions. For example, as disclosed at page 7, line 21, of the as-filed and as-amended '071 Specification and at page 7, line 6, of the as-filed '620 Specification, a consumer instruction dictates both a payment amount and a payment date. Thus, the lack of the phrase "in accordance with the consumer instructions" does not add new matter.

Page 4, line 21, of the as-filed '071 Specification recites: "...information to input into..." Amendment A, discussed above, changed this to recite "...information to be input into...". This change, also as discussed above, does not constitute new matter. Also as discussed above, the change did not get published in the '113 Patent, and in fact what was printed did not even appear in the as-filed or as-amended '071 Specification. Page 5, line 3, of the as-filed '620 Specification recites: "...information to input into...". Thus, the '620 Specification reads as does the as-filed '071 Specification. Accordingly, no new matter is found at page 5, line 3, of the as-filed '620 Specification.

Page 4, line 23, of the as-filed '071 Application recites: "...telephone and...". Amendment A, the entry of which did not constitute new matter, as discussed above, changed this to read "...telephone number...". Page 5, line 4, of the as-filed '620 Specification reads as does the as-amended '071 Specification at page 4, line 23. Accordingly, page 5, line 4, of the as-filed '620 Specification does not contain new matter.

Page 5, lines 2-4, of both the as-filed and as-amended '071 Specification recites: "The consumer's information may then be input via keyboard 52 or other input means such as a scanner into the consumer database record 22." Page 5, lines 6-7, of the as-filed '620 Specification recites: "The consumer's information may then be manually input via a keyboard 52 into the consumer database record 22." Thus, the as-filed '620 Specification adds the word "manually", adds the word "a"

before "keyboard", and excludes the phrase "or other input means such as a scanner".

As to the addition of the word "manually", it is well understood that data entry via keyboard is manual data entry. Thus, the meaning of the sentence is not changed by the addition of this word, accordingly no new matter results. And, certainly the addition of the word "a" does not constitute new matter.

As to the deletion of the phrase "or other input means such as a scanner", as the '620 Continuation Application explicitly incorporates the disclosure of the '071 Application, even though this text does not appear in the as-filed '620 Specification, that Specification should be read as if that text were included. Thus, obviously no new matter has been added.

Page 5, lines 12-16, of the as-filed '071 Specification includes the sentence "In short, the service provider takes a risk whenever paying consumer's bills on the service provider's account since there is a slight chance the consumer may not reimburse the service provider after the provider has already made payment." The as-filed '620 Specification lacks this sentence. However, due to the incorporation-by-reference statement, the as-filed '620 Specification should be read as if it appears. Obviously no new matter has been added by the exclusion of this sentence.

Page 5, lines 21, through page 6, line 6, of the as-filed and as-amended '071 Specification reads: "FIF 24 is a database of financial institutions' identification codes and financial institution account information for the consumer. This file also edits the accuracy of the financial institution's routing transit number and the bank account number supplied by the consumer. If the numbers do not correspond with the correct routing and bank numbers, they are rejected and the data entry is corrected and repeated".

Page 5, lines 15-19, of the as-filed '620 Specification reads: "FIF 24 is a database of financial institutions' identification codes and account information for the consumer. This file edits the accuracy of the routing transit number and the bank account number. If the numbers do not correspond with the correct routing and bank numbers, they are rejected and the data entry is done again".

As seen, the as-filed '620 Specification excludes text found in the as-filed and as-amended '071 Specification. As to the deleted text, because of the incorporation-

by-reference statement, the as-filed '620 Specification should be read as if these deletions are present. Further, it is clear from the text of both the '071 Application and the '620 Application that financial institution information is received from consumers. As to the use of the phrase "done again" in the '620 Continuation Application versus "repeated" in the '071 Application, it will be recognized these are equivalents, thus this difference does not constitute an addition of new matter.

Page 6, lines 13-16, of both the as-filed and as-amended '071 Specification recites: "In addition, an electronic pre-note 28 will be created...". Page 6 lines 6-9, of the as-filed '620 Specification recites: "In addition, to comply with federal law, an electronic pre-note 28 will be created...". The additional text does not add new matter to the invention as disclosed in the '071 Application. Both the as-filed '071 Specification and the as-filed '620 Specification teach that a pre-note is utilized because of federal law. Page 13, lines 4-5, of the as-filed '071 Specification recites: "The present pre-note period under Federal Law is ten (10) days". Page 11, lines 15-16 of the as-filed '620 Specification recites: "The pre-note period is ten (10) days under federal law." Thus, even though the reference to federal law is absent from page 6, lines 6-9, of the as-filed '620 Specification, it is taught elsewhere in the '620 Continuation Application. Accordingly, the exclusion does not constitute new matter.

Page 6, line 18, of the as-filed '071 Specification recites: "amounts". As discussed above, Amendment A changed this to recite: "amount". Also as discussed above, the change of Amendment A did not introduce new matter, as the as-filed '071 Application discloses single and multiple credit limit amounts. The as-filed '620 Specification recites: "amounts", as does the as-filed '071 Specification. Thus, this referenced text in the as-filed '071 Specification is the same as the referenced text in the as-filed '620 Specification. Thus, this difference does not constitute new matter.

Page 6, line 21, through page 7, line 9, of the as-filed '071 Specification recites: "In Figure 3 the steps are shown for establishing merchants to be paid and the service provider making a payment. The consumer must inform the service provider or processor of a merchant's name, address, phone number and the consumer's account number with the merchant 32. This information is put into a merchant master file database 42 (MMF). MMF 42 also includes settlement information on each merchant to indicate the form of payment the merchant will accept. MMF 42 also acts as an editor ensuring proper payment format. The term

"merchant" as used herein is intended to pertain to any person or entity that the consumer wishes to pay and is not to be limited to the usual merchants most consumers pay, such as, department stores, the electric company, a home mortgage lender, etc.".

Amendment A, discussed above, modified this referenced text in the '071 Application to make "merchants" plural in the second sentence, and to remove the comma following "such as". Neither of these changes, as discussed above, constitute the insertion of new matter into the as-filed '071 Application.

Page 6, lines 12-18, of the as-filed '620 Specification recites: "In Figure 2 the steps are shown for establishing merchants to be paid and the making of a payment. The consumer must inform the service provider or processor of a merchant's name, address, phone number and the consumer's account number with the merchant 32. The term "merchant" as used herein is intended to pertain to any person or entity that the consumer wishes to pay and is not to be limited to the usual merchants most consumers pay, such as the electric company, a home mortgage lender, etc. This information is put into a merchant master file database 42 (MMF).

Differences exist between the as-filed '620 Specification and the as-amended '071 Specification in the referenced text. The first difference, to be discussed in detail below, is the '071 Application reference to Figure 3 and the '620 Continuation Application reference to Figure 2. As will be shown below, this does not constitute new matter. The next difference is also in the first sentence of the referenced text. While the two sentences are worded somewhat differently, both sentences have the same meaning. The '620 Continuation Application lacks the phrase "service provider", but as will be recognized that phrase appears throughout the '620 Continuation Application. Further, because of the incorporation-by-reference statement, the '620 Continuation Application should be read as including all the disclosure of the '071 Application. Clearly, the lack of the term "service provider" in this sentence does not constitute new matter.

The sentence "The term ... mortgage lender, etc." appears in both the as-filed '071 Application and the as-filed '620 Continuation Application. However, its placement in the '620 Continuation Application is different than that in the '071 Application. A reading of both the '071 Specification and the '620 Specification shows that the movement of this text in no way changes its meaning, or the meaning

of any other text, in the '620 Continuation Application. Accordingly, this difference does not constitute new matter.

The sentences beginning with "MMF 42..." and ending with "...payment format" are excluded from the '620 Continuation Application. However, other portions of the as-filed '071 Specification and the as-filed '620 Specification teach that the MMF may contain settlement information for a merchant. For example, page 14, lines 13-14, of the as-filed '071 Specification and page 12, line 18, of the as-filed '620 Specification both recite: "Various merchant's settlement codes may be established". Thus, exclusion of the sentence from the '620 Specification does not add new matter to the invention disclosed in the '071 Application. In any event, because of the incorporation-by-reference statement the '620 Continuation Application should be read as including all the disclosure of the '071 Application, including this excluded sentence.

Page 7, lines 13-17, of the as-filed '071 Specification recites: "...monthly, such as, weekly, quarterly, etc. The consumer should inform the service provider of the date ...". Amendment A removed the comma following "such as". As discussed above, this does not constitute the addition of new matter into the '071 Application. Page 7, lines 1-3, of the as-filed '620 Specification recites: " monthly, such as weekly, quarterly, etc. The consumer should information the service-provider of the date...". Thus, the '620 Continuation Application reflects Amendment A, which does not constitute new matter. The referenced text in the '620 Continuation Application recites "service-provider", while the referenced text in the '071 Application recites "service provider". Obviously the addition of this hyphen does not constitute new matter.

Page 7, line 18, of both the as-filed and as-amended '071 Application includes the text "e.g.". Discussed above, the as-published '113 Patent includes "e.g.", but not underlined. Page 7, line 4, of the as-filed '620 Continuation Application recites: "e.g.", but also not underlined. As is clear, the lack of underlining does not in any way change the meaning of the term, and thus does not constitute new matter.

Page 7, line 25, through page 8, line 6, of the as-filed '071 Specification recites: "On a personal computer, as payments are initiated, a consumer "checkbook register" may be created and automatically updated to reflect this activity. The merchant list may be visible on the consumer's personal computer screen. On a

personal computer a consumer may enter merchant payment amounts and payment dates on the computer screen then transmit this information to the service provider."

Amendment A, which as discussed above did not result in adding new matter to the '071 Application, deleted the comma following "computer" in the first sentence and changed the final sentence to read "A consumer may..." instead of "On a personal computer a consumer may...".

Page 7, lines 9-13, of the as-filed '620 Specification recites: "As payments are initiated, a consumer "checkbook register" may be created and automatically updated to reflect this activity. The merchant list can be visible on the consumer's personal computer screen. On a personal computer a consumer may enter merchant payment amounts and payment dates on the computer screen and then transmit this information to the service provider".

As seen, the as-filed '620 Specification differs slightly from both the as-filed '071 Specification and the as-amended '071 Specification. In particular, the text "On a personal computer," beginning the first sentence in the referenced text in the as-filed '071 Application is excluded. However, the next sentence in both the '071 Application and the '620 Continuation Application recites: "personal computer screen". Thus, it is clear from a reading of the '620 Continuation Application that a "checkbook register" may be created when payments are initiated on a personal computer, as a computer screen is a part of a personal computer. In any event, because of the incorporation-by-reference statement, the '620 Specification should be read as including the complete disclosure of the '071 Application. This difference in no way constitutes new matter.

The next difference in this referenced text is in the second sentence. The word "may" in the as-filed '071 Specification is replaced by "can" in the as-filed '620 Specification. A simple reading of the two versions of this sentence shows that this difference in no way adds new matter to the invention disclosed in the as-filed '071 Application.

The final sentence of the referenced text in the as-filed '071 Specification recites "On a personal computer". Amendment A removed this language. The final sentence of the referenced text in the as-filed '620 Continuation Application includes the text removed by Amendment A. Accordingly, this text cannot be considered new matter because it appeared in the as-filed '071 Specification. Furthermore, as

discussed above in relation to Amendment A, the meaning of the sentence is not changed whether or not the sentence begins with “On a personal computer”. The final sentence in the referenced text in the as-filed ‘620 Specification also includes the word “and” following “screen”. A reading of this sentence in the ‘071 Application versus a reading of this sentence in the ‘620 Continuation Application clearly impart the same meaning. The addition of “and” in no way constitutes new matter.

Page 8, lines 11-19, in both the as-filed and as-amended ‘071 Specification recites: “If yes, the voice may instruct the consumer to enter the amount to be paid by pressing the numbers on a touch tone phone in accordance with a predetermined code. For example, the digits 0-9 may represent corresponding numerical digits in the amount of dollars to be paid. The asterisk button could be used as a decimal point or represent an entry of cents. Once the amount is entered, the voice may ask the consumer to enter the date on which payment is to be made to the merchant”.

Page 7, lines 17-20, of the as-filed ‘620 Specification recites: “If yes, the voice may instruct the consumer to enter the amount to be paid by pressing the numbers on a touch tone phone. The asterisk button could be used as a decimal point. After the amount is entered, the voice may ask the consumer to enter the date on which payment is to be made to the merchant”.

As seen, the ‘620 Continuation Application lacks the example of digits corresponding to numerical values found in the ‘071 Application. In the as-filed ‘071 Specification the example does not limit the invention. Rather, the example is but one way to achieve inputting of numbers via a touch tone phone. In other words, the example is not a required feature of the disclosed invention. The exclusion of this language from the as-filed ‘620 Specification does not constitute new matter. As to the use of the word “after” instead of “once”, it is clear that the meaning of the sentence is not changed due to this difference. Both sentences teach that a consumer may be prompted for a payment date subsequent to the consumer entering a payment amount, thus this difference does not constitute new matter. In any event, because of the incorporation-by-reference statement, the ‘620 Continuation Application should be read as including all the disclosure of the ‘071 Application. For this reason also, this difference does not constitute new matter.

Page 8, lines 19-21, of the as-amended ‘071 Specification recites: “This may be accomplished by assigning each month a number, such as January being month

01; February being month 02; etc. The consumer may then enter month, day and year for payment. For example, Jul. 9, 1991 may be entered as 070991". As discussed above, Amendment A adds the word "being" after "February", but does not constitute an addition of new matter.

Page 7, line 20-through page 8, line 2, of the as-filed '620 Specification recites: "This may be accomplished by assigning each month a number, such as January being month 01. The consumer may then enter month, day and year for payment", with "For example ... 070991" being excluded. Similar to the discussion above, the examples of "February being month 02" and "070991" do not limit the invention disclosed in the as-filed '071 Specification. Rather, they are but illustrative of how a particular date could be input. In any event, because of the incorporation-by-reference statement, the '620 Continuation Application should be read as including all the disclosure of the '071 Application, including this example. Thus, this difference does not constitute new matter.

Page 8, line 25 through page 9, line 2, of both the as-filed and as-amended '071 Specification recites: "It may communicate with a data processor to obtain consumer information from the individual consumer's database file". Page 8, lines 3-4, of the as-filed '620 Specification recites: "It may communicate with a data processor to obtain consumer information." This exclusion of "from the individual consumer's database file" does not add new matter to the invention disclosed in the '071 Application. Page 5, lines 2-3, of the as-filed '071 Specification and page 5, lines 6-7, of the as-filed '620 Specification both teach that consumer information is stored in a consumer database. Further, due to the incorporation-by-reference statement, the '620 Specification should be read as including all the disclosure of the '071 Application, including obtaining information from an individual consumer's database file.

Page 9, lines 10-15, in both the as-filed and as-amended '071 Specification recites: "Any new merchant record and account numbers are added to the consumer's pay table 38. New merchants are compared to the MMF 42 and appropriately cross-referenced by the software of the present invention to the pay table to check if a merchant record already exists". Page 8, lines 10-13, of the as-filed '620 Specification excludes the text "and account numbers", "38", and "by the software of the present invention", reading: "Any new merchant record and account

numbers are added to the consumer's pay table 38. New merchants are compared to the MMF 42 and appropriately cross-referenced by the software of the present invention to the pay table to check if a merchant record already exists".

When read in context with the preceding sentence, "The consumer's records may be edited 44 for validity by comparing to the merchants' account scheme", as well as in context of the rest of the disclosed invention, it is clear that while "and account numbers" does not appear in this text of the '620 Specification, "merchant records" might, but are not required to, include account numbers. Thus, exclusion of the phrase "and account numbers" does not constitute new matter. As to the exclusion of the number "38", because this text is describing the processing shown in Figures 4A, B, and C and the pay table is labeled "38" in these Figures, exclusion of "38" in no way alters the meaning of this text because detail 38 in the Figures is labeled "Consumer pay table". Thus, this difference does not constitute new matter.

The referenced test of '620 excludes "by the software". As seen in both the as-filed '071 Specification and the as-filed '620 Specification, one implementation of the disclosed invention is achieved by the use of software. In any event, because of the incorporation-by-reference statement the excluded language should be read into the '620 Continuation Application. As such, these exclusions do not constitute new matter.

Page 9, line 24, of both the as-filed and as-amended '071 Specification recites: "...pay table 38 to determine...". Page 9, line 1, of the as-filed '620 Specification recites: "...pay table to determine...". This exclusion of "38" does not introduce new matter, as discussed above.

Page 10, lines 5-6, of the as-filed and as-amended '071 Specification reads: "This may be accomplished by a Troy printer which puts a micr code on drafts, comparable to the manner in which the code is included on standard personal checks". Page 9, lines 5-6, of the as-filed '620 Specification reads: "This may be accomplished by a printer which puts a micr code on drafts, like standard personal checks". Because of the incorporation-by-reference statement, the excluded information should be read into the '620 Specification from the '071 Specification. This difference does not constitute an addition of new matter.

Page 10, lines 7-8, of both the as-filed and as-amended '071 Specification recites: "In Figure 1, the front end...". Page 9, lines 6-7, of the as-filed '620

Specification reads: “For example, as shown in Figure 5, the front end....”. As will be discussed in detail further below, the Figures in the ‘620 Continuation Application are numbered differently from the Figures of the ‘071 Application. Figure 5 of the ‘620 Continuation Application does not disclose new matter. As such, this difference does not result in new matter in the ‘620 Specification.

Page 10, line 10, of both the as-filed and as-amended ‘071 Specification recites: a “private branch exchange...” Page 9, lines 8-9, of the as-filed ‘620 Specification recites: a private bank exchange (PBX)...”. As will be recognized by one of ordinary skill in the art, the terms “private branch exchange” and “private bank exchange” are often used interchangeably. Furthermore, not only is “PBX” a well-known acronym for both “private branch exchange” and “private bank exchange”, the acronym “PBX” appears in Application the Figures of both the ‘071 Application and the ‘620 Continuation Application. As such, this difference in the as-filed ‘620 Specification does not add new matter.

Page 10, lines 12-15, of both the as-filed and as-amended ‘620 Specification recites: “...is performed by the software to determine...”. Page 9, lines 10-12, of the as-filed ‘620 Specification recites: “...is performed to determine...”. As is clear from a reading of both Specifications, one implementation of the disclosed invention is achieved by the use of software, as discussed above. Further, because of the incorporation-by-reference statement the excluded language should be read into the ‘620 Continuation Application. As such, this exclusion obviously does not add new matter.

As discussed above, Amendment A changed page 10, line 16 of the as-filed ‘071 Specification to recite “...through the Federal Reserve Automated Clearing House (ACH) Network...” from “...through the Federal Reserve ACH Network...”. This change, also discussed above, did not introduce new matter. Page 9, line 13, of the as-filed ‘620 Specification recites: the same language resulting from Amendment A. Likewise, this language in the ‘620 Specification does not constitute new matter.

Page 10, lines 20-24, of the as-filed ‘071 Specification recites: “...attached to a Troy micr post printer ... or consolidated check 78(check made payable to a single merchant to cover payments for a number of consumers who all owe the same merchant)...”. Amendment A changed this to read “attached to a micr post

processor ...or consolidated checks 78(checks made payable to a single merchant to cover payments for a number of consumers who all owe the same merchant)...". As discussed above, this amendment did not introduce new matter. Further, the change from "Troy printer" to "processor" was made at the Examiner's request. Page 9, lines 16-17, of the as-filed '620 Specification recites: the language of Amendment A, but for "printer" instead of "processor", and but for "(checks made payable to a single merchant to cover payments for a number of consumers who all owe the same merchant)". As "processor" appeared in the as-filed '071 Specification, inclusion here cannot constitute new matter. As for the exclusion of the parenthetical statement, because of the incorporation-by-reference statement, the '620 Specification should be read as including this disclosure.

Page 11, lines 5-8, of both the as-filed and as-amended '071 Specification recites: "Alternatively, when the consumer uses a personal computer 37 to instruct the service provider, the personal computer may access...". Page 10, lines 1-3, of the as-filed '620 Specification recites: "Figure 6 illustrates a similar arrangement for use when the consumer is using a personal computer 37 to instruct the service provider. The personal computer may access...". With reference to the discussion below relating to the Figures as filed in the '620 Continuation Application, these differences between the '071 Application and '620 Continuation Application do not constitute new matter. Furthermore, a reading of the two sentences imparts the same meaning. Namely, that whenever a consumer uses a personal computer, that computer may access the front end processor through a standard network. Thus, no new matter is added to the '071 Application.

Page 11, lines 10-11, of the as-filed '071 Specification recites: "The payment process cycle 56 may be initiated each day, or more or less frequently". Amendment A, which as discussed above did not introduce new matter, changed this to recite "The payment process cycle 56 may be initiated each day, or more or less frequently". Page 10, lines 5-6, of the as-filed '620 Specification recites: "The payment process may be cycled 56 each day or more or less frequently". Clearly, the meaning of each version of this sentence is the same. As such, no new matter is introduced into the '620 Continuation Application due to this difference.

Page 11, lines 13-18, of both the as-filed and as-amended '071 Specification recites: "A processing calendar means 58 such as a clock may be built into the

system. ... Payments are released from the consumer pay table 38 using the due date input by the consumer and maintained in the consumer database." Page 10, lines 8-10, of the as-filed '620 Specification lacks some of this language, reciting "A processing calendar 58 may be built into the system. ... Payments are released from the consumer pay table 38 using the due date". Because of the incorporation-by-reference statement, the excluded information should be read into the '620 Specification from the '071 Specification. This difference in no way constitutes new matter.

Page 12, lines 2-4, of the as-filed '071 Specification recites: "Assigned factors determine if a payment will be released as a paper item, or an ACH electronic transaction (automated clearing house)". Amendment A removed "automated clearing house". As discussed above, this amendment did not add new matter to the invention disclosed in the as-filed '071 Specification. Page 10, lines 18-19, of the as-filed '620 Specification recites: "There are several factors in the process used to determine if a payment will be released as a paper item, or an ACH electronic transaction (automated clearing house)". Both the '071 and the '620 Specification teach "several factors". As will be recognized, they include, but are not limited to, a payment amount and whether a consumer's bank can process electronic transactions. Thus, the term "several" appearing in the as-filed '620 Specification does not introduce new matter. Also, exclusion of the term "assigned" from the as-filed '620 Specification does not constitute new matter. Further, inclusion of the phrase "automated clearing house" cannot be new matter, as it appeared in the as-filed '071 Specification.

Page 12, lines 7-10, of the as-filed '071 Specification recites: "If a consumer's status is pending 60 when the payment processing cycle is initiated by the processing calendar 58, the payment should go out as a draft paper to protect the service provider". Amendment A requested a comma to be added after "60". As discussed above, this did not constitute the addition of new matter. Page 11, lines 1-3, of the as-filed '620 Specification recites: "If a consumer's status is pending 60, when reviewing the payment file with the processing calendar 58, the payment should go out as a draft paper to protect the service provider".

This sentence is slightly different than found in either the as-filed '071 Specification or the as-amended '071 Specification. The as-filed '620 Specification

does not explicitly recite in this sentence that the payment processing cycle is initiated by the processing calendar. However, page 11, lines 11-13, of the as-filed '620 Specification and page 10, lines 6-8 of the as-filed '071 Specification each recite "The first step is to establish when payment items are to be processed. This may be accomplished through a processing calendar 58." Thus, initiating processing by a processing calendar is taught in both Applications, notwithstanding page 11, lines 1-3, of the as-filed '620 Specification lacking this language. In any event, because of the incorporation-by-reference statement, the '620 Continuation Application should be read as including all the features disclosed in the as-filed '071 Application. Accordingly, this difference does not constitute new matter.

Page 12, lines 12-14, of both the as-filed and as-amended '071 Specification recites: "The consumer's bank account codes are actually encoded onto the draft (as shown in Figure 5) prepared by the service provider, much like the consumer's personal check." Page 11, lines 4-6, of the as-filed '620 Specification recites: "The consumer's bank account codes are actually encoded onto the draft prepared by the service provider and act much like the consumer's personal check." As will be discussed in detail further below, the '620 Continuation Application was filed without Figure 5 of the '071 Application. However, because of the incorporation-by-reference statement, the '620 Continuation Application includes the disclosure of the '071 Application, including Figure 5. As for the exclusion of a comma following "provider" and addition of the phrase "and act" before "much", these changes do not add new matter, as the meaning of both sentences is the same.

Page 12, line 24, of the as-filed '071 Specification recites: "(i.e. ....". Amendment A requested this be changed to "(i.e., ....". As discussed above, this change, which clearly did not introduce new matter, as it was merely an editorial change, was not reflected in the as-published '113 Patent. Page 11, line 12, of the as-filed '620 Specification recites: "(i.e.,....". For the same reasons that the addition of the comma requested by Amendment A did not constitute new matter, this difference in the as-filed '620 Specification does not constitute new matter.

Page 13, lines 4-5, of the as-filed '071 Specification reads: "The present pre-note period under federal Law is ten (10) days." As discussed above, Amendment A modified this to read "The present pre-note period under federal law is ten (10) days". The changing of "Federal Law" to lower case did not introduce any new

matter. Page 11, lines 15-16, of the as-filed '620 Specification reads: "The pre-note period is ten (10) days under federal law." It should be clear to anyone reading these sentences that the movement of "is ten (10) days" and the exclusion of "present" does not change the meaning of the sentence. Thus, no new matter is introduced into the as-filed '620 Specification in this sentence.

As discussed above, page 13, line 17, of the as-filed '071 Specification recites: "check limit". Amendment A requested that this be changed to "'credit limit". As discussed above, this change did not introduce new matter, as whenever the service provider writes a check the service provider is extending credit to a consumer. Page 12, line 4, of the as-filed '620 Specification recites: "check limit". Since this is the same as the as-filed '071 Specification, clearly no new matter is introduced.

Page 13, lines 18-19, of both the as-filed and as-amended '071 Specification recites: "the item may be released as an electronic payment 74". Page 12, line 5, of the as-filed '620 Specification recites: "the item may be released as electronic 74." Clearly this difference does not add new matter. A reading of both sentences conveys the same meaning. And, in any event, because of the incorporation-by-reference statement, the disclosure of the '071 Application should be read into the '620 Specification.

Page 13, lines 21-22, of the as-filed '071 Specification recites: "released as electronic 74". Amendment A modified this to recite "released as an electronic payment 74". As discussed above, this change requested by Amendment A did not introduce new matter. Page 12, line 7, of the as-filed '620 Specification recites: "released as electronic payment 74". Thus, only a part of Amendment A is reflected in the as-filed '620 Specification. It will be clear from the discussion of Amendment A above, and from a reading of the sentence appearing in the as-filed '620 Specification, each version of this sentence has the same meaning. Thus, the differences between the as-filed '620 Specification and the as-filed '071 Specification and the as-amended '071 Specification do not introduce new matter.

As discussed above, page 14, line 4, of the as-filed '071 Specification recited "check limit". Amendment A modified this to read "credit limit". As discussed above, this change does not constitute new matter. The as-filed '620 Specification, at page 12, line 12, recites: "credit limit", in accordance with Amendment A. For the same

reasons, this does not add new matter to the invention disclosed in the '071 Application.

Page 14, lines 15-19, of the as-filed '071 Specification recites: "...remittance list 78 mailed ... code, such as, '10' produce ... code, such as, '13' produce ...". Amendment A requested that this text be changed to "...remittance list 78 being mailed ... code such as '10' produce ... code such as '13' produce ...". As discussed above, the changes due to Amendment A did not introduce new matter into the as-filed '071 Specification. Page 12, lines 19 through page 13, line 2, of the as-filed '620 Specification recites: "...remittance list 78 being mailed ... code, such as '10' produce ... code, such as '13' produce ...". Thus, the as-filed '620 Specification, in this instance, is a blend of the as-filed '071 Specification and the as-amended '071 Specification. In particular, the as-filed '620 Specification reflects the addition of "being" and the removal of a comma after each of the two instances of "such as". Reading each of the versions of the sentence in which the above-reference text appears reveals that each teaches the same invention. That is, they each have the same meaning. No new matter exists in the as-filed '620 Specification due to the differences between the '620 Specification and either of the as-filed '071 Specification or the as-amended '071 Specification.

Page 14, lines 23-24, of the as-filed '071 Specification reads: "For variable payments, once made they are deleted on the consumer pay table". As discussed above, Amendment A requested this sentence to be changed to "For variable payments, once made the payment date is deleted from the consumer pay table". The change of Amendment A, as discussed above, did not add new matter to the invention disclosed in the as-filed '071 Application. Page 13, lines 5-6, of the as-filed '620 Specification reads: "For variable payment once made, the payment date is deleted on the consumer pay table". Thus, the only difference between the as-amended '071 Specification and the as-filed '620 Specification is a placement of a comma after "made" in the '620 Specification, instead of after "payments", as in the '071 amended Specification. A reading of the as-amended sentence compared with a reading of the as-filed '620 sentence clearly reveals that these two sentences have the same meaning, thus no new matter is added by the mere moving of a comma.

Page 15, lines 5-7, of the as-filed and as-amended '071 Specification recites: "The software of the present invention makes several decisions related to particular

transactions for consumers as shown in Figures 4A, B, C". Page 13, lines 10-11, of the as-filed '620 Specification recites: "The software of the present invention is designed in part to make several decisions relating to particular transactions for consumers." The exclusion of "as shown in Figures 4A, B, C" does not constitute new matter. The processing of Figures 4A, B, and C is described in detail in both the '071 and the '620 Specifications preceding this sentence. The sentence containing the differences is an introductory sentence to a particular example of the processing of Figures 4A, B, and C described above. Furthermore, because of the incorporation-by-reference statement, the as-filed '620 Specification includes the disclosure of the as-filed '071 Specification.

As for the other differences in the sentence, it is clear from a reading of the two sentences that they impart the same information. The differences are merely editorial in nature and do not add new matter to the invention as disclosed in the '071 Application.

Page 15, lines 12-15, of the as-filed and as-amended '071 Specification reads: "For this example, assume that a consumer has five transactions of varying amounts to different merchants for which the consumer has asked the service provider to arrange payment". Page 13, lines 15-16, of the as-filed '620 Specification recites: "For this example, assume that a consumer has five transactions of varying amounts for which the consumer has asked the service provider to arrange payment".

Because of the incorporation-by-reference statement the '620 Continuation Application should be read as including the disclosure of the '071 Application, which includes the language "to different merchants". Furthermore, the inventive processing being described is not dependent upon an identity of an entity receiving payment. Stated another way, it does not matter who a payee of any of the five payments is, the processing of the payments would be the same in any case. Accordingly, this difference does not constitute new matter.

Page 15, line 20, of the as-filed '071 Specification recites: "to be paid, are". Amendment A requested that this language be changed to "to be paid are". Page 14, line 1, of the as-filed '620 Specification recites: "paid, are", as does the as-filed '071 Specification. This difference between the as-filed '620 Specification and the as-amended '071 Specification does not rise to the level of new matter because, as

discussed above, the change requested by Amendment A does not give rise to new matter. The meaning of the sentence in which this language appears is was not changed by amendment A.

Page 16, lines 8-10, of the as-filed and as-amended '071 Specification recites: "In this example, the initial payment of \$25.00 falls within the \$50.01 edit and will be paid without any further edits being conducted for this particular payment." Page 14, lines 10-11, of the as-filed '620 Specification recites: "In this example, the initial payment of \$25.00 will satisfy the \$50.01 edit and therefore will be paid without any further edits being conducted for this particular payment." It is clear from a reading of these two sentences that they have the same meaning. The '071 Specification and the '620 Specification both teach that a payment amount that is less than an exemplary dollar amount, \$50.01 in this example, will be paid. Accordingly, this difference does not constitute new matter.

Page 16, line 21, of the as-filed '071 Specification recites: "case, is". Amendment A requested that this language be changed to "case is". The as-published '113 Patent reflects this amendment. Page 14, line 18, of the as-filed '620 Specification recites: "case, is", as does the as-filed '071 Specification. This difference between the as-filed '620 Specification and the as-amended '071 Specification does not rise to the level of new matter because, as discussed above, the change requested by Amendment A does not give rise to new matter. The meaning of the sentence in which this language appears is was not changed by amendment A.

Page 16, line 23, of the as-filed '071 Specification recites: "therefore, go". Amendment A requested that this language be changed to "therefore go". As discussed above, Amendment A, which was entered, was not included in the as-published '113 Patent. Page 15, line 2, of the as-filed '620 Specification recites: "therefore, go", as does the as-filed '071 Specification. This difference between the as-filed '620 Specification and the as-amended '071 Specification does not rise to the level of new matter because, as discussed above, the change requested by Amendment A does not give rise to new matter. The meaning of the sentence in which this language appears is was not changed by amendment A.

Page 17, line 22, of the as-filed '071 Specification recites: "example, fails". As discussed above, Amendment A requested this language be changed to recite

"example fails". Also as discussed above, the entered amendment is not reflected in the as-published '113 Patent. Page 15, line 18, of the as-filed '620 Specification recites: "example fails". Thus, concerning this phrase, as-filed '620 Specification is the same as the as-amended '071 Specification. Amendment A, by removing the comma, corrected an obvious grammatical error. The filing of the '620 Specification with this comma removed does not in any way change the meaning of the sentence in which it appears. As such, this difference does not constitute new matter.

As will be understood from the discussion above, the differences between the text of the '620 Specification and the '071 Specification in no way constitute any type of new matter.

Introduced above, the Figures of the as-filed '620 Continuation Application are different than the Figures of the '071 Application. However, as will be discussed in detail below, the differences in the Figures in no way constitute any type of new matter.

With reference to Exhibit K, the '620 Continuation Application was filed with eight informal Figures, Figure 1, Figure 2, Figure 3, Figure 4a, Figure 4b, Figure 4c, Figure 5, and Figure 6.

Exhibit N, found at tab 14, is a side-by-side comparison of the Figures of the '113 Patent (which are the same as the as-filed '071 Figures) with the corresponding as-filed Figures of the '620 Continuation Application.

With reference to Sheet N-1 and Sheet N-2 of Exhibit N, Figure 1 of the '113 Patent is split into two Figures in the as-filed '620 Figures, Figure 5 and Figure 6. As shown on Sheet N-1, all of the numbered details of Figure 1 of the '113 Patent are reproduced in the as-filed '620 Figure 5, except for details 37 and 43. As shown on Sheet N-2, all of the numbered details of Figure 1 of the '113 Patent are reproduced in the as-filed '620 Figure 6, except for details 35, 39, and 41. Stated another way, each of as-filed '620 Figures 5 and 6 include details 40, 46, 47, 48, 49, 50, 52, 54, 76, and 78 of Figure 1 of the '113 Patent, with the as-filed '620 Figure 5 including details 35, 39, and 41, and with the as-filed '620 Figure 6 including details 37 and 43. When as-filed '620 Figures 5 and 6 are taken together, each of the numbered details of Figure 1 is reproduced.

Figure 1 of the '113 Patent includes a first unnumbered box situated between Front End Processor 40 and each of the X.25 Network 43 and the vru 41 and a

second unnumbered box situated between computer 46 and each of the Federal Reserve ACH Network 47, the Laser Printer/Troy Post Processor 48, and the MasterCard RPS Network 49. These unnumbered boxes are not reproduced in either of the as-filed '620 Figure 5 or Figure 6. However, for two reasons, this exclusion does not constitute new matter. First, due to the incorporation-by-reference statement, the entire disclosure of the '071 Application, including Figures, should be read into the '620 Continuation Application, including that taught in the Figures.

The second reason that the exclusion of these unnumbered boxes from the as-filed Figures of the '620 Applications does not constitute new matter is that the information conveyed by these unnumbered boxes is conveyed by the text of both the Specification of the '071 Application and the Specification of the '620 Continuation Application.

The first unnumbered box includes the text "consumer initiated instructions/consumer system records". As will be recognized from the discussion above, as well as from a reading of the '071 Application and a reading of the '620 Continuation Application, the exchange of instructions and records between the front end processor 40 and both the X.25 Network and the vru 41 is disclosed in the text of the '071 and '620 Specifications. For example, page 7, lines 18-20, of the as-filed '071 Specification and page 7, lines 4-5, of the as-filed '620 Specification each recite: "Through a telecommunications terminal 34 (e.g., a push-button telephone or computer terminal), a consumer may initiate payment of bills". Also, page 9, lines 2-4, of the as-filed '071 Application and page 8, lines 4-6, of the as-filed '620 Specification each recite: "At the end of the consumer's session on the terminal a confirmation number may be sent to the consumer, providing a record of the transaction." Thus, the exchange of both consumer initiated instructions and consumer system records are disclosed in the Specification of both Applications and as such the exclusion of the first unnumbered box does not constitute new matter.

The second unnumbered box includes the text "merchant payments". As will be recognized from the discussion above, as well as from a reading of the '071 Application and a reading of the '620 Continuation Application, merchant payments can be made either via the Federal Reserve ACH Network 47, via paper (check or draft), and via the MasterCard RPS network 49. For example, the as-filed '071

Specification at page 10, lines 15-25, and the as-filed 'Specification, at page 9, lines 12-17, each teach these three modes of payment.

As for the numbered details that are reproduced in the as-filed '620 Figures, in four of these details there are minor differences from Figure 1 of the '113 Patent. Detail 50 of Figure 1 of the '113 Patent is labeled "memory means". Detail 50 of Figures 5 and 6 of the as-filed '620 Continuation Application is labeled "disk". Because of the incorporation-by-reference statement the '620 Continuation Application includes the full disclosure of the as-filed '071 Application, including features disclosed in the Figures. Thus, detail 50 in Figures 5 and 6 of the '620 Continuation Application should be understood to be a 'memory means'. Also, it is well understood in the art that a disk is a memory means. Accordingly, the labeling of detail 50 as 'disk' does not introduce new matter for these two reasons.

Detail 78 of Figure 1 of the '113 Patent is labeled "check list". Detail 78 of Figures 5 and 6 of the as-filed '620 Continuation Application is labeled "check & list". This minor difference in labeling is supported by both the '071 Application and the '620 Continuation Application. In particular, page 14, line 15, of the as-filed '071 Specification and page 12, line 19, of the as-filed '620 Specification each recite "check and remittance list 78". Thus, this minor difference does not constitute new matter.

Detail 48 of Figure 1 of the '113 Patent is labeled "laser printer/troy post processor". Detail 48 of Figures 5 and 6 of the as-filed '620 Continuation Application is labeled "laser printer/troy post processor". This obvious inadvertent error is corrected by Formal Drawings, to be discussed further below.

Detail 41 in Figure 1 of the '113 Patent is labeled "vru". Detail 41 in Figure 5 of the '620 Continuation Application is labeled "voice response unit (vru)". The text of the as-filed '071 Specification, at page 8, lines 23-24, and the text of the as-filed '620 Specification, at page 8, lines 2-3, each recite: "The programmed voice may be accomplished with a vru (voice response unit)". As this slight variation in labeling is supported by each Specification, it does not introduce new matter.

Detail 39 in Figure 1 of the '113 Patent is labeled "PBX". Detail 39 in Figure 5 of the '620 Continuation Application is labeled "Private Bank Exchange (PBX)". As discussed above, "private bank exchange" is not recited in the '071 Application. However, also as discussed above, the terms "private bank exchange" and private

branch exchange" are often used interchangeably. Thus, this difference between the as-filed '620 Figure 5 and the '113 Patent Figure 1 does not constitute new matter.

An unnumbered box in Figure 1 of the '113 Patent is labeled "Macintosh PC". The same unnumbered box in Figure 6 of the '620 Continuation Application is labeled "Macintosh". This slight difference obviously does not add new matter. Further, as will be discussed below, this difference is corrected by Formal Drawings.

Figure 1 of the '113 Patent and Figures 5 and 6 of the '620 Continuation Application each include directional arrows. Some of the directional arrows in the '620 Figures do not match those in Figure 1 of the '113 Patent. The arrow between details 40 and 46 of Figure 1 of the '113 Patent is shown as bi-directional. The same arrow in Figures 5 and 6 of the '620 Continuation Application is shown as being unidirectional. However, as will be discussed further below, this is corrected by Formal Drawings.

The arrow between details 35 and 39 of Figure 1 of the '113 Patent is shown as bi-directional. The same arrow in Figure 5 of the '620 Continuation Application is shown as being unidirectional. However, as will be discussed further below, this is corrected by Formal Drawings.

Details 39 and detail 41 of Figure 1 of the '113 Patent are shown being connected by two unidirectional arrows with opposite direction. The same details in Figure 5 of the '620 Continuation Application are shown being connected by a single unidirectional arrow. As will be discussed further below, this is corrected by Formal Drawings.

Details 40 and detail 41 of Figure 1 of the '113 Patent are shown being connected by two unidirectional arrows with opposite direction. The same details in Figure 5 of the '620 Continuation Application are shown being connected by a single unidirectional arrow. As will be discussed further below, this is corrected by Formal Drawings.

The arrow between details 37 and 43 of Figure 1 of the '113 Patent is shown as bi-directional. The same details in Figure 6 of the '620 Continuation Application are shown as being connected by a line with no arrow ends. However, as will be discussed further below, this is corrected by Formal Drawings.

The arrow between detail 43 and the "Macintosh PC" of Figure 1 of the '113 Patent is shown as bi-directional. The same items in Figure 6 of the '620

Continuation Application are shown as being connected by a line with no arrow ends. However, as will be discussed further below, this is corrected by Formal Drawings.

Detail 43 and detail 40 of Figure 1 of the '113 Patent are shown being connected by two unidirectional arrows with opposite direction. The same details in Figure 6 of the '620 Continuation Application are shown being connected by a single unidirectional arrow. As will be discussed further below, this is corrected by Formal Drawings.

With reference to Sheet N-3 of Exhibit N, Figure 2 of the '113 Patent is reproduced as Figure 1 of the '620 Continuation Application. Each detail of Figure 2 of the '113 Patent is reproduced in Figure 1 of the '620 Continuation Application. Figure 2 of the '113 Patent includes several arrows linking Figure 2 with other Figures of the '113 Patent. Not all of these linking arrows are reproduced in Figure 1 of the '620 Continuation Application. However, because of the incorporation-by-reference statement, the complete disclosure of the '071 Application should be read into the '620 Continuation Application, including the linking arrows of Figure 2 of the '113 Patent. Figure 1 of the '620 Continuation Application should be understood to include the linking arrows. This, no new matter is found here.

Figure 2 of the '113 Patent includes several directional arrows. Likewise, Figure 1 of the '620 Continuation Application includes several directional arrows. But for the arrow linking details 22 and 24, these arrows are the same. Figure 2 of the '113 Patent shows a unidirectional arrow pointing toward detail 22, while Figure 1 of the '620 Continuation Application shows a bi-directional arrow. As will be clear from the discussion below, this difference in arrows does not constitute new matter.

A unidirectional arrow generally denotes a one-way flow, and a bi-directional arrow generally denotes a two-way flow. Detail 24 is the FIF File. Detail 22 is the consumer database. The Specification of both the as-filed '071 Application and the as-filed '620 Continuation Application each support two-way flow between the FIF and the consumer database, even though Figure 2 of the '113 Patent only depicts a unidirectional arrow. In particular, page 5, lines 17-25, of the as-filed '071 Specification and page 5, lines 13-18, of the as-filed '620 Specification each teach that bank routing transit and individual account numbers are input into a computer system and that this information can be edited against the financial institutions file (FIF) database 24, which is a part of the computer system. The information in the

FIF that is used for editing “may be obtained from each banking institution and each consumer”, as recited at page 6, lines 6-7, of the as-filed ‘071 Specification and at page 6, lines 1-2, of the as-filed ‘620 Specification. Thus, information received from consumers is passed to the FIF for storage, and information stored in the FIF is retrieved from the FIF to edit received financial institution information. Accordingly, the Specification of both the ‘071 Application and the ‘620 Continuation Application teach a flow of information into and out of the FIF. Therefore, the inclusion of a bi-directional arrow in Figure 1 of the ‘620 Continuation Application does not constitute new matter.

In fact, the storage of received consumer information in the FIF is one of the hallmark characteristics of this invention, as this builds a database of financial institution information used to validate the accuracy of information received from consumers based upon information received from other consumers. That is, the service provider does not have to rely solely upon financial institutions to supply information used in validations. This is a direct solution to the problem of past bill payment systems noted in the Background of both the as-filed ‘071 Specification and the as-filed ‘620 Specifications. Both Specifications recite: “The banks that do provide that type of service [bill payment] are limited in that they provide the service only for their own customers since the banks have not developed a system for accurately acquiring and processing account numbers ... of all other banking institutions...”

With reference to Sheet N-4 and Sheet N-5, part of Figure 3 of the ‘113 Patent appears in Figure 2 of the ‘620 Continuation Application, and part of Figure 3 of the ‘113 Patent appears in Figure 3 of the ‘620 Continuation Application. With particular reference to Sheet N-4, details 32, 34, 36, and 40 are reproduced in Figure 2 of the ‘620 Continuation Application. And, with particular reference to Sheet N-5, details 34, 38, 40, 42 and 44 are reproduced in Figure 3 of the ‘620 Continuation Application.

Detail 32 and detail 36 are labeled the same in Figure 2 of the ‘620 Continuation Application as they are in Figure 3 of the ‘113 Patent. Details 38, 42, and 44 are labeled the same in Figure 3 of the ‘620 Continuation Application as they are in Figure 3 of the ‘113 Patent.

Figure 2 of the '620 Continuation Application includes a link connecting details 32 and 36. This link does not appear in Figure 3 of the '113 Patent. Detail 32 represents information identifying a merchant. Detail 36 represents a payment request. The arrows included in both Figure 3 of the '113 Patent and Figure 2 of the '620 Continuation Application represent that information flowing to the service provider from a consumer. The link does not include arrow ends. As such, it does not denote any information flow. Rather, it shows an association between a payment request and information identifying a merchant. Both the as-filed '071 Specification and the as-filed '620 Specification teach receiving information identifying a new merchant in association with a payment request and adding that merchant identifying information to a database. For example, see page 9, lines 5-9 of the '071 Specification and page 9, lines 8-14, of the '620 Specification. Because the association between a payment request and a new merchant is disclosed in the '071 Specification, the inclusion of the link representing the association in Figure 2 of the '620 Continuation Application does not constitute new matter.

Detail 40 in Figures 2 and 3 of the '620 Continuation Application is labeled "c.f. front end process". Formal Drawings, to be discussed below, change this to read "front end processor". Detail 40 of Figure 3 of the '113 Patent is labeled "front end processor".

Detail 34 in Figures 2 and 3 of the '620 Continuation Application is labeled "consumer telecommunication terminal". As will be discussed below, the label of detail 34 of Figures 2 and 3 of the '620 Continuation Application is changed to "consumer telecommunication device" by Formal Drawings. Detail 34 in Figure 3 of the '113 Patent is labeled "consumer telecommunication device for instructions and receipt of system records (pc, telephone, terminal, etc)". Because of the incorporation-by-reference statement, the label of detail 34 of Figures 2 and 3 of the '620 Continuation Application should be read to include the language not reproduced from Figure 3 of the '113 Patent. Further, as will be apparent from the discussion above, both the '071 Specification and the '620 Specification disclose the exchange of instructions and records via pc, telephone or other type terminal. As such, no new matter is found here.

Figure 3 of the '620 Continuation Application lacks details 56 and 58 present in Figure 3 of the '113 Patent. However, because of the incorporation-by-reference

statement, all the disclosure of the '071 Application is included in the '620 Continuation Application, including these details missing from Figure 3 of the '620 Continuation Application. Further, details 56 and 58, and their interaction, is described in both the Specification of the '071 Application and the Specification of the '620 Continuation Application, in addition to also being depicted in Figure 4a of the '113 Patent and Figure 4a of the '620 Continuation Application. Accordingly, this does not constitute new matter.

Figure 3 of the '620 Continuation Application includes an unnumbered box labeled "rejects". This unnumbered box does not appear in Figure 3 of the '113 Patent. The text of the as-filed '071 Application and the text of the as-filed '620 Continuation Application disclose rejecting information received at the front end processor. In particular, attention is drawn to page 9, lines 18-20, of the as-filed '071 Application and page 8, lines 15-18, of the as-filed '620 Continuation Application. This text recites: "The payment [received via the front end processor] may first go through a validation process against the pay table 38<sup>1</sup>. The validation process checks for duplicate payments and if duplicates are found they are sent to a reject file." Thus, inclusion of the unnumbered box labeled "rejects" does not constitute new matter, rather it merely illustrates an aspect of the invention disclosed in both the '071 Application and the '620 Continuation Application, namely, rejecting duplicate payment requests.

Figure 3 of the '620 Continuation Application also lacks a reference to Figure 4b. However, because of the inclusion-by-reference statement, the disclosure of the '071 Application is included in the '620 Continuation Application, including this reference to Figure 4b. Further, the text of both the '071 and '620 Applications clearly teach the processing of Figures 3 and 4a as linked. Thus, this does not constitute new matter.

With reference to Sheet N-6 of Exhibit A, Figure 4a of the '113 Patent is reproduced as Figure 4a of the '620 Continuation Application. The Figure 4a of the '620 Continuation Application only contains minor variations from that of the '113 Patent. In particular, details 60 and 62 in Figure 4a of the '620 Continuation Application lack "?" following the text. However, as will be discussed further below, this is corrected by Formal Drawings. Further, the Figure 4a of the '620 Continuation

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<sup>1</sup> As discussed above, the as-filed '620 Application does not recite "38".

Application lacks a reference to Figure 4b. This too is corrected by the Formal Drawings.

The consumer database in Figure 4a of the '113 Patent is labeled "consumer database A", and has a detail number of "22A". Also, this Figure includes a reference arrow showing that this is the same consumer database of Figure 2 of the '113 Patent. Figure 4a of the '620 Continuation Application uses a different notation convention. Rather than using reference arrows, letter designations following detail numbers, and labels to show sameness between Figures, this convention utilizes the same labels and reference numbers. Accordingly, the consumer database of Figure 4a of the '620 Continuation Application is labeled "consumer database", has detail number 22, and lacks the reference arrow. Thus, the Figure 4a of the '620 Continuation Application and the Figure 4a of the '113 Patent disclose the same exact processing utilizing the same exact components. Therefore, Figure 4a of the '620 Continuation Application discloses the exact features disclosed in Figure 4a of the '113 Patent. No new matter is found here.

With reference to Sheet N-7 of Exhibit N, Figure 4b of the '113 Patent is reproduced in Figure 4b of the '620 Continuation Application. There are minor differences between these two Figures. Namely, Figure 4b of the '620 Continuation Application lacks the detail number "65", lacks a reference to Figures 4a and 4c, and lacks a "?" in the text appearing in details 64, 65, and 66. However, as will be discussed below, each of these is corrected in Formal Drawings.

Figure 4b of the '620 Continuation Application also lacks a reference to Figure 3. However, because of the inclusion-by-reference statement, the disclosure of the '071 Application is included in the '620 Continuation Application, including this reference to Figure 3. And further, the linkage between Figures 3 and 4b of the '620 Continuation Application is clear from the text of the Application. This difference does not constitute new matter.

With reference to Sheet N-8 of Exhibit N, Figure 4c of the '113 Patent is reproduced in Figure 4c of the '620 Continuation Application. There are minor differences between these two Figures. Namely, Figure 4c of the '620 Continuation Application lacks the detail number "71", lacks a reference to Figure 4b, and lacks a "?" in the text appearing in details 68, 70, and 71. Figure 4c of the '620 Continuation

Application also includes slightly different text in detail 71. However, as will be discussed below, each of these is corrected in Formal Drawings.

Similar to the discussion above, a different notation convention is utilized in Figure 4c of the '620 Continuation Application than in Figure 4c of the '113 Patent. This results in slight differences in the representation of detail 22, which appears twice in the 4c Figures. As will be understood from the discussion above, this does not lead to any differences between the teachings of the Figures, and thus does not constitute new matter.

As seen, detail 78 is slightly different in Figure 4c of the '620 Continuation Application than in Figure 4c of the '113 Patent. However, this is corrected by Formal Drawings, to be discussed below.

Figure 4c of the '113 Patent shows a unidirectional arrow pointing from detail 22c to detail 76. Figure 4c of the '620 Continuation Application shows this arrow in the opposite direction. This is an obvious drafting error, as this is not supported in the text of the '071 Specification, or the text of the '620 Specification. This error does not introduce new matter.

The Figures of the '620 Continuation Application do not include a Figure corresponding to Figure 5 of the '113 Patent. Figure 5 of the '113 Patent depicts a draft. The text of the '620 Specification discloses the draft, as does the text of the '071 Specification, even though the draft is not explicitly depicted in the Figures of the '620 Continuation Application. Because of the incorporation-by-reference statement, the '620 Continuation Application includes the complete disclosure of the '071 Application. Thus, even though Figure 5 is not reproduced in the '620 Continuation Application this does not in any constitute new matter, as Figure 5 of the '071 Application is incorporated into the '620 Continuation Application by the incorporation-by-reference statement.

On September 28, 1988 Formal Drawings were filed during the prosecution of the '620 Application. These Formal Drawings correct the differences between the as-filed '620 Figures and Figures of the '113 patent noted above. The Formal Drawings were published in the '072 Patent. Exhibit P, found at tab 16, is a side-by-side comparison of the Figures of the '072 Patent with the as-filed Figures of the '620 Continuation Application.

Exhibit Q, found at tab 17, is a side-by-side comparison of the as-published Figures of the '072 Patent and the as-published Figures of the '113 Patent. As will be understood from the discussion above, none of the differences between the Figures of the '113 Patent and the '072 patent result in any addition of new matter.

As seen in Exhibit Q, Figure 4C of the Formal Drawings, at detail 72, includes a drafting error. The "create ACH debit" item has two detail numbers, number 72 and number 47, whereas the as-filed Figure 4C of both the '071 Application and the '620 Continuation Application do not show "47" in association with "create ACH debit". This obvious drafting error of including "47" does not introduce new matter.

### The Third Application

Exhibit R, found at tab 18, is a copy of a Specification as originally filed on February 16, 1999 as a part of a Continuation Application for Patent claiming priority to the filing date of the '113 Patent through the '072 Patent. The United States Patent and Trademark Office assigned this Continuation Application a Serial Number of 09/250,675. The '675 Continuation Application became abandoned on August 7, 2002. Exhibit S, found at tab 19, is a copy of Figures as originally filed with the '675 Continuation Application, which are an exact copy of the Formal Drawings submitted during the prosecution of the '620 Continuation Application.

The Specification of the '675 Continuation Application differs from the as-filed '620 Specification in three respects. First, the Related Applications section of the '675 Specification differs, necessarily, from that of the as-filed '620 Specification. The Related Applications section of the '675 Specification references both the '072 Patent and the '113 Patent, whereas the Related Applications section of the '620 Specification references only the '113 Patent. This difference obviously does not introduce new matter.

The next difference between the '675 Specification and the '620 Specification is found at page 1, line 16, through page 2, line 2, of the '675 Specification and at page 1, lines 13-17, of the '620 Specification. This difference relates to the Submission of the microfiche appendix. The '620 Specification recites: "A microfiche appendix has been submitted with the parent case of this Application Serial No. 07/736071 which is to issue as United States Letters Patent, No.

5,383,113 on January 17, 1995 which contains...". An Amendment during the prosecution of the '620 Application amended this to recite: "A microfiche appendix has been submitted with the parent case, Application Serial No. 07/736,071, now issued as United States Letters Patent No. 5,383,113 on January 17, 1995 which contains...". The Specification of the '675 Application recites: "A microfiche appendix has been submitted with the parent case of this Application Serial No. 07/736,071, which issued as United States Letters Patent No. 5,383,113 on January 17, 1995, which contains...". This difference obviously does not introduce new matter.

The final difference between the '675 Specification and the '620 Specification is found at page 6, line 3, of the '675 Specification and at page 7, line 3, of the '620 Specification. The '675 Specification recites: "service provider". The '620 Specification recites: "service-provider". Again, this difference obviously does not introduce new matter.

As should be understood from the discussion above, the as-filed '675 Continuation Application does not contain any new matter beyond the disclosure of the as-filed '620 Continuation Application. Also as should be understood from the discussion above, the as-filed '620 Continuation Application does not contain any new matter beyond the disclosure of the as-filed '071 Application. As such, the as-filed '675 Continuation Application does not contain any new matter beyond the disclosure of the as-filed '071 Application.

#### The Fourth Application

On March 20, 2002 a Continuation Application for Patent claiming priority to the filing date of the '113 Patent through the '675 Continuation Application and the '072 Patent was filed. The United States Patent and Trademark Office assigned this Continuation Application a serial number of 09/540,011. The Specification and Figures of the '011 Continuation Application are exact copies of that found in the '675 Continuation Application.

Because the as-filed '011 Continuation Application is an exact copy of the as-filed '675 Continuation Application, no new matter can be included in the as-filed '011 Continuation Application. As discussed above, the as-filed '675 Continuation

Application contains no new matter beyond the disclosure of the as-filed '620 Continuation Application. Because of this, the as-filed '011 Continuation Application contains no new matter beyond the disclosure of the as-filed '620 Continuation Application. Also as discussed above, the as-filed '620 Continuation Application contains no new matter beyond the disclosure of the as-filed '071 Application. Because of this, the as-filed '011 Continuation Application contains no new matter beyond the disclosure of the as-filed '071 Application. Accordingly, continuity of disclosure has been maintained throughout the series of Applications, from the first filed '071 Application all the way through the latest filed '011 Continuation Application. As such, the '011 Application is entitled to the benefit of the filing date of the '113 Patent, July 25, 1991.



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